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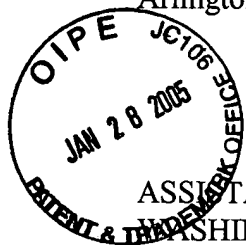
TRANSMITTAL LETTER AND
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

> RE: Attorney Docket No.: CAT/29US-SCRCO3
>   Application Serial No.: 09/756,788
>   Filed: 1/10/2001
>   Title: System and Method for Providing Shopping Aids and Incentives to
>   Customers Through a Computer Network
>   Inventor: SCROGGIE et al.
>   Group Art Unit: 3622
>   Examiner: JANVIER

SIR:

Attached hereto for filing are the following papers:

37 CFR 1.143 Response to Election of Species Requirement
37 CFR 41.37 Supplemental Appeal Brief and Second Request for Reinstatement of the Appeal
(in Triplicate)
Attachment 1

Our check in the amount of $0.00 is attached covering the required fees.

The Commissioner is hereby authorized to charge any fees which may be required, or
credit any overpayment, to Deposit Account Number 50-2106 . A duplicate copy of this sheet
is enclosed.

1/28/2005

Date

Richard A. Neifeld, Ph.D.
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NEIFELD DOCKET NO: CAT/29US-SCRCO3

<u>IN THE UNITED STATES PATENT & TRADEMARK OFFICE</u>

IN RE APPLICATION OF: CONFIRMATION NO. 6599

Michael C. SCROGGIE et al.

US APPLICATION NO: 09/756,788

FILED: January 10, 2001

GROUP ART UNIT: 3622

EXAMINER: JANVIER

TITLE: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

<u>37 CFR 1.143 RESPONSE TO ELECTION OF SPECIES REQUIREMENT</u>

Sir:

In response to the office action mailed October 29, 2004, applicant responds as follows:

I.   **The Restriction Requirement**

In the office action mailed October 29, 2004, the examiner stated that:

1.   Restriction to one of the following inventions is required under 35 USC

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      I.   Claims 32-56 and 59-91, drawn to a method of and system for

delivering incentives over the Internet comprising a Web site for

providing purchasing incentives from multiple sources, a consumer

purchase history database based on consumer online shopping

activity, a consumer database, which can identify consumers by

their e-mail addresses, wherein said consumer database is

connected to said Web site so as to receive consumer data from

said Web site and means for delivering purchasing incentives to

consumers by e-mail.

      II.   Claim 57, drawn to a method of and system for providing, via a

Web site, purchasing incentives from multiple sources such as

retailers and manufacturers comprising a personal database, a

consumer purchase history database based on consumer online

shopping activity, **means for generating a web page with a**

consumer-specific display and means for updating said web

page.

      III.   Claim 58, drawn to a method for delivery of incentives by e-mail,

comprising the steps of maintaining a consumer database, which

identifies consumers by their e-mail addresses, generating targeted

purchase incentives from a consumer purchase history database

and **formatting an e-mail message to a consumer by electronic**

mail for subsequent printing of a coupon and delivering said e-

mail to the consumer.

The inventions are distinct, each from the other because of the following

reasons:

For example, Inventions I and II are related as combination and

subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page**.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. [Office action mailed October 29, 2004 page 2 line 18 through page 4 line 13.]

II.   Provisional Election with Traverse

In response, the applicant provisionally elects group I, claims 32-56 and 59-91 <u>with</u> <u>traverse</u>. The applicant traverse the requirement because the requirement does not comply with authority binding upon the examiner for the many reasons noted below.

The MPEP is binding upon the examiner insofar as it is the procedural requirements imposed on the examiner by the Director. Therefore, a restriction requirement that fails to comply with the MPEP is improper and should be withdrawn. Cf. <u>In re Portola</u>, 110 F.2d 786, 788, 42 USPQ2d 1295, ___ (Fed. Cir. 1997).

III.   The Restriction Requirement is After Final Action

MPEP 802 Basis for Practice in Statute and Rules states in pertinent part that:

37 CFR 1.142 Requirement for restriction.
(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the

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reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). **Such requirement will normally be made before any action on the merits; however, it may be made at any time <u>before final action</u>**. [Emphasis supplied.]

The plain meaning of the emphasized portion of 37 CFR 1.142 cited above is that a request for restriction cannot be made after final action. The passage "Such requirement will normally be made before any action on the merits;" indicates the normal course of action. The passage "however, it may be made at any time before final action" is a catch-all description for the timing of a restriction requirement. MPEP 802 Basis for Practice in Statute and Rules makes no provision for a restriction requirement <u>after final action</u>.

Moreover, MPEP 818.03(a) Reply Must Be Complete, quoting 37 CFR 1.111(b) states in pertinent part that:

> The applicant's or patent owner's reply must appear throughout to be a *bona fide* attempt to advance the application or the reexamination proceeding to final action. . . .

By stating that an applicant's reply to a restriction requirement must advance the proceeding to final action, MPEP 818.03(a) indicates that a restriction requirement must be made before final action.

The subject restriction requirement was imposed after a second final action mailed May 4, 2004, after a first final action mailed September 17, 2003, after a first appeal brief in response to the first final action mailed September 17, 2003, and after request to reinstate the appeal and second appeal brief in response to the second final action mailed May 4, 2004. Therefore, a restriction requirement, which was made <u>after final action</u>, is improper and should be withdrawn.

IV.   **No Burden on Examiner for a Search and Examination of an Entire Application**

      A.   **The Restriction Requirement Fails to Comply with MPEP 803**

            1.   **MPEP 803 Restriction - When Proper**

MPEP 803 states the burden on the examiner for a search and examination of an entire application:

> If the search and examination of an entire application can be made without

serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

The applicant points out that the examiner has not shown that examining invention groups I, II, and III, in this application imposes a serious examination burden.

Given the erroneous analysis as to combination/subcombination and the scope of claimed subject matter, and the absence of separate classifications, the election requirement is improper and should be withdrawn.

Given that the examiner has been working on all claims in this application and the application has twice been finally rejected, there appears to be no possibility of any significant burden in continued examination, <u>particularly</u> after appeal.

2. **MPEP 803 Guidelines**

In its Guidelines section, MPEP 803 states that:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02.

MPEP 808.02 states that:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(c) - 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) **Separate classification thereof**: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together**: Even though they are classified together, each subject can be shown to have

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formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing parents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search**: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

The examiner has concluded that the inventions are distinct, stating in the office action mailed October 29, 2004 on page 4 lines 7-13:

. . . In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The subcombination has separate utility by itself such as **means for generating a web page with a consumer-specific display and means for updating said web page**.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art and required a separate search and hence, restriction for examination purposes as indicated is proper.

The examiner has not met the serious burden for purposes of the initial requirement, of showing by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP 808.02, Therefore, the applicants assert that the election of species requirement is improper and should be withdrawn.

B.   **The Restriction Requirement Runs Counter to MPEP 706.07**

MPEP 706.07 states the conditions precedent to final rejection or action. MPEP 706.07 states in pertinent part that:

> Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be **thoroughly searched in the first action** and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. [Emphasis supplied.]

<div align="center">* * *</div>

> While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," **present practice does not sanction hasty and ill-considered final rejections.** [Emphasis supplied.]

<div align="center">* * *</div>

> In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be **clearly developed** to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection. [Emphasis supplied.]

The three passages above from MPEP 706.07 reinforce the assertion that a thorough search and examination of an entire application must be performed prior to final action. Since the examiner is required to perform a thorough search and examination of an entire application prior to final action, the search and examination has already been performed and there is no serious burden on the examiner for a search and examination of an entire application after final action as specified above by MPEP 803. Therefore, the restriction requirement is improper and should be withdrawn.

C. The Restriction Requirement Runs Counter to MPEP 811

MPEP 811 dictates the time for making a requirement for restriction, stating in pertinent part that:

> Before making a restriction requirement after the first action on the merits,
> the examiner will consider whether there will be a serious burden if restriction is
> not required.

The examiner has not justified that there is a serious burden if restriction is not required. The examiner's assertion that a separate search is required is untenable, since according to MPEP 706.07 (cited above), a complete search must be performed prior to issuing a final action.

Since the examiner has not shown a serious burden if restriction is not required, the election requirement is improper and should be withdrawn.

V. The Restriction Requirement Fails to Comply with MPEP 816

MPEP 816 states that:

816 Give Reasons for Holding of Independence or Distinctness

> The particular reasons relied on by the examiner for holding that the
> inventions as claimed are either independent or distinct should be concisely
> stated. A mere statement of conclusion is inadequate. The reasons upon which the
> conclusion is based should be given.
>
> For example, relative to combination and a sub-combination thereof, the
> examiner should point out the reasons why he or she considers the
> subcombination to have utility by itself or in other combinations, and why he or
> she considers that the combination as claimed does not rely on the
> subcombination as its essential distinguishing part.
>
> Each other relationship of claimed invention should be similarly treated
> and the reasons for the conclusions of distinctness of invention as claimed set
> forth.
>
> The separate inventions should be identified by a grouping of the claims

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with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See MPEP § 809.

The applicant points out that, with respect to the group I claims, the examiner has not pointed out "the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not rely on the subcombination as its essential distinguishing part."

Specifically, the examiner provides no rationale for why the combination as claimed does not require the particulars of the subcombination as claimed [Office action mailed October 29, 2004 page 4 lines 7-8.] Therefore, there is no support for the factual predicate upon which the examiner bases the restriction analysis.

Moreover, the examiner has not classified the groups of the alleged three inventions, as specified in MPEP 816.

Furthermore, the examiner has not provided reasoning with respect to Invention I and Invention II, Invention I and Invention III, and Invention II and Invention III indicating why the examiner believes these inventions are legally distinct.

Therefore, for all the foregoing reasons, the restriction requirement is improper and should be withdrawn.

VI.   **The Restriction Requirement Fails to Comply with MPEP 817**
MPEP 817 states that:

817 Outline of Letter for Restriction Requirement Between Distinct Inventions

The statement in MPEP § 809.02 through § 809.02(d) is adequate indication of the form of letter when election of species is required.

No outline of a letter is given for other types of independent inventions since they rarely occur.

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The following outline of a letter for a requirement to restrict is intended to cover every type of original restriction requirement between related inventions including those having linking claims.

OUTLINE OF LETTER

(A) Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121

(1) Identify each group by Roman numeral.

(2) List claims in each group. Check accuracy of numbering of the claims; look for same claims in two groups; and look for omitted claims.

(3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product.

(4) Classify each group.

The examiner has not given a "short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, sub-combination, process, apparatus, or product," as required by MPEP 817.

Additionally, the examiner has not classified the groups of the alleged three inventions, as specified in MPEP 817(4).

Moreover, the examiner has not shown that any of the three groups meet any criteria for restriction relative to the other group, as required by MPEP 817.

Therefore, the restriction requirement is improper and should be withdrawn.

VII. **The Serious Burden Placed Upon the Applicants by the Requirement**

The applicants request that the examiner keep in mind the serious (and often unnecessary) financial burden placed upon *the applicants* in having to split prosecution between division applications in response to restriction requirements, particularly at this late stage of prosecution. Given the applicant's reliance in filing two appeal briefs and the examiner's undue

delay in asserting an office action necessitating a requirement for restriction, the applicants assert that the doctrines of equitable estoppel and laches apply. Accordingly, the applicants request that the examiner drop the restriction requirement, as being equitably improper under the doctrines of reliance estoppel and laches.
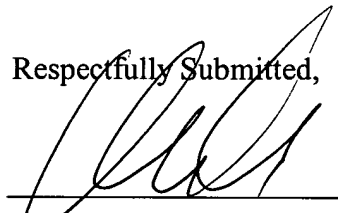
VIII. Closure

For all of the foregoing reasons, the election requirement is improper and should be withdrawn. Therefore, the examiner should withdrawn the requirement and proceed to examine the application for compliance with all other statutory requirements.

Should Examiner Janvier have any questions, the examiner is urged to contact the undersigned at (703) 415-0012.

Respectfully Submitted,

Date

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

Printed: January 27, 2005 (4:49pm)
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NEIFELD DOCKET NO: CAT29US-SCRCO3

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: CONFIRMATION NO. 6599

MICHAEL C. SCROGGIE ET AL.

US APPLICATION NO: 09/756,788

FILING DATE: January 10, 2001

GROUP ART UNIT: 3622

EXAMINER: JANVIER

TITLE: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.37 SECOND SUPPLEMENTAL APPEAL BRIEF AND REQUEST FOR REINSTATEMENT OF THE APPEAL

Sir:

In response to the non-final office action mailed October 29, 2004 re-opening prosecution, the applicants reinstated the appeal and file this second supplemental appeal brief, pursuant to 37 CFR 41.37.

Table of Contents

I.   **37 CFR 41.37**

This brief sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

II.   **37 CFR 41.37(b)**

The filing is timely. Accordingly, this subsection is not relevant.

III.   **37 CFR 41.37(c)(1)**

A.   **37 CFR 41.37(c)(1)(i) Real Party in Interest**

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Florida corporation.

B.   **37 CFR 41.37(c)(1)(ii) Related Appeals and Interferences**

Appeals are pending in the following related applications:

1.   US Application No.: 09/478,351, filed October 8, 2002 (Neifeld Ref.: CAT/29-SCROCO2CP). The applicants filed an appeal brief September 11, 2003. The applicants filed a response to election of species requirement, a request for reinstatement of appeal, and a supplemental appeal brief on December 22, 2003. The applicants filed a second supplemental appeal brief May 20, 2004. The applicants filed a reply brief on August 24, 2004. Notification stating that the reply brief was forward to the Board was mailed on October 8, 2004.

2.   US Application No.: 09/567,274, filed May 9, 2000 (Neifeld Ref.: CAT/29-SCROCO3). The applicants filed an appeal brief January 28, 2003. The applicants filed a reply brief on October 16, 2003. The Board of Patent Appeals and Interferences assigned Appeal No. 2004-1420 on May 17, 2004. A decision on appeal was mailed on August 18, 2004. The applicants filed a request for rehearing on October 18, 2004.

3.   US Application No.: 09/401,939 filed September 23, 1999 (Neifeld Ref.: CAT/29US-SCROCO). The applicants filed an appeal brief on March 14, 2003. The applicants filed a reply brief on September 17, 2003. The Board of Patent Appeals and Interferences assigned Appeal No. 2004-0989 on February 15, 2004. A decision on appeal was mailed November 22, 2004.

4.   US Application No.: 09/401,198, filed September 23, 1999 (Neifeld Ref.: CAT/29US-SCROD1). The applicants filed an appeal brief on October 9, 2001. The applicants filed a reply brief July 1, 2002. The Board of Patent Appeals and Interferences assigned Appeal No. 2003-1733 on July 9, 2003. The Board remanded the case back the to Examiner August 28, 2003. The Board of Patent Appeals and Interferences assigned Appeal No. 2004-0738 on February 19, 2004. A decision on appeal was mailed November 30, 2004.

5.   US Application No.: 09/410,086, filed October 1, 1999 (Neifeld Ref.: CAT/29US-SCROD2). The applicants filed an appeal brief on July 24, 2002. The applicants filed a substitute appeal brief March 6, 2003. The Examiner's Answer was mailed on December 23, 2003.

6.   US Application No.: 90/005,888, filed December 12, 2000 (Neifeld Ref.: SCROREEX634). This reexamination is not yet under appeal. The applicants filed an amendment in reexamination and remarks in response to the notice regarding defective paper in ex parte reexamination on April 3, 2003. An office action was mailed from the PTO on January 30, 2004. An appeal brief was filed June 20, 2004. This appeal brief was refiled December 2, 2004.

7.   US Application No.: 09/716,404, filed November 21, 2000 (Neifeld Ref.: CAT/29-SCROCO4). The applicants filed an appeal brief January 29, 2003; in the absence of a response by the USPTO, the appeal brief was refiled on October 1, 2003. A notice of allowability was mailed on 11/10/2004.

8.   US Application No.: 09/756,787, filed January 10, 2001 (Neifeld Ref.: CAT/29US-SCRCO2). A non-final office action was mailed October 28, 2004. The applicants plan to file an appeal brief.

C.   **37 CFR 41.37(c)(1)(iii) Status of Claims**
Claims 32-91 are pending, rejected, and under appeal.

D.   **37 CFR 41.37(c)(1)(iv) Status of Amendments**
All amendments are entered.

E.   **37 CFR 41.37(c)(1)(v) Summary of Claimed Subject Matter**

The invention of claim 32 is a system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 3 lines 12-16, page 18 lines 27-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and means for delivering purchasing incentives to consumers by e-mail (page 20 lines 17-19).

The invention of claim 33 is the system of claim 32 wherein said means for delivering purchase incentives delivers purchasing incentives based on consumer profile (page 19 lines 25-26).

The invention of claim 34 is the system of claim 32 wherein the consumer purchase history database and said consumer database are integrated (page 20 lines 28-29).

The invention of claim 35 is the system of claim 32 wherein said Web site is an independently administered Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 36 is the system of claim 32 wherein said Web site is a cooperative site (page 5 lines 28 through page 6 line 2).

The invention of claim 37 is the system of claim 32 wherein said consumer purchase history database includes data based on past purchasing activity (page 21 lines 4-5).

The invention of claim 38 is the system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and a means for delivering by e-mail notices which remind consumers to visit said Web site (page 20 lines 17-19 and page 21 lines 25-27).

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The invention of claim 39 is the system of claim 38 wherein said means for delivering e-mail notices delivers notices based on consumer profile (page 19 lines 25-26).

The invention of claim 40 is the system of claim 38 wherein the consumer purchase history database and said consumer database are integrated (page 20 lines 28-29).

The invention of claim 41 is the system of claim 38 wherein said Web site is an independently administered Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 42 is the system of claim 38 wherein said Web site is a cooperative Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 43 is the system of claim 38 wherein said consumer purchase history includes data based on past purchasing activity (page 21 lines 4-5).

The invention of claim 44 is the system for delivering incentives over the Internet comprising: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); a consumer database which can identify consumers by their e-mail addresses (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3), wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site (page 20 lines 29 through page 21 line 1); and means for delivering by e-mail notices to purchase a specific manufacturer's product (page 20 lines 17-19).

The invention of claim 45 is the system of claim 44 wherein said means for delivering e-mail notices delivers notices based on consumer profile (page 19 lines 25-26).

The invention of claim 46 is the system of claim 44 wherein the consumer purchase history database and the consumer database are integrated (page 20 lines 28-29).

The invention of claim 47 is the system of claim 44 wherein said Web site is and independently administered Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 48 is the system of claim 44 wherein said Web site is a cooperative Web site (page 5 lines 28 through page 6 line 2).

The invention of claim 49 is the system of claim 44 wherein said consumer purchase history database includes data based on past purchasing activity (page 21 lines 4-5).

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The invention of claim 50 is the method for delivering purchasing incentives over the Internet comprising the steps of: providing a Web site which offers shopping incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); receiving a consumer's e-mail address from a consumer's computer (page 20 lines 29 through page 21 line 3); maintaining a consumer email database which can identify consumers by their e-mail address (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3); and transmitting purchase incentives via an e-mail post office (page 21 lines 4-8).

The invention of claim 51 is the method of claim 50 wherein the step of transmitting purchase incentives to the consumer by electronic mail includes transmitting purchase incentives based on a consumer profile (page 21 lines 4-19).

The invention of claim 52 is the method of claim 50 wherein the step of providing a Web site is performed by an independent Web site administrator (page 5 lines 28 through page 6 line 2).

The invention of claim 53 is the method of claim 50 wherein the step of providing a Web site is achieved cooperatively (page 5 lines 28 through page 6 line 2).

The invention of claim 54 is the method for delivering incentives over the Internet comprising the steps of: a Web site for providing purchasing incentives from multiple sources (page 18 lines 21-29); a consumer purchase history database based on consumer online shopping activity (page 23 lines 6-16, page 22 lines 10-17, and page 20 line 25 through page 21 line 1); receiving a consumer's e-mail address from a consumer's computer (page 20 lines 29 through page 21 line 3); maintaining a consumer email database which can identify consumers by their e-mail address (page 15 lines 4-10, page 20 lines 26-27, and page 20 line 29 through page 21 line 3); and transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office (page 21 lines 25-27).

The invention of claim 55 is the method of claim 54 wherein the step of providing a Web site is performed by an independent Web site administrator (page 5 lines 28 through page 6 line 2).

The invention of claim 56 is the method of claim 54 wherein the step of providing a Web site is achieved cooperatively (page 5 lines 28 through page 6 line 2).

The invention of claim 59 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises shopping list selections data (page 14 lines 13-20).

The invention of claim 60 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises rebate offers data (page 12 line 21).

The invention of claim 61 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises notices detailing specific offers data (page 21 lines 27-29).

The invention of claim 62 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises focused incentives based on a consumer's prior shopping activity data (page 19 lines 25-26).

The invention of claim 63 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises purchasing incentives for data defining coupons for subsequent printing by a consumer (page 21 lines 8-10).

The invention of claim 64 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises links to at least one of manufacturer and retailer web sites (page 15 lines 18-20).

The invention of claim 65 is the system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises data enabling a consumer to request at least one of information regarding a product and a sample of said product (page 12 line 22 and page 12 line 25).

The invention of claim 66 is the system of claim 32 wherein said consumer purchase history database stores data from any online shopping activity (page 23 lines 9-10).

The invention of claim 67 is the system of claim 32 wherein said consumer purchase history database stores an administrator of said system's web site data (page 20 lines 28-30).

The invention of claim 68 is the system of claim 32 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands data (page 6 lines 17-23 and page 23 lines 8-9).

The invention of claim 69 is the system of claim 32 wherein said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address (page 14 line 27 through page 15 line 1 and page 19 lines 22-23).

The invention of claim 70 is the system of claim 32 wherein said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household (page 14 line 27 through page 15 line 1).

The invention of claim 71 is the system of claim 32 further comprising code for generating targeted, time phased incentives based on a consumer's actual buying patterns and preferences (page 21 lines 10-13).

The invention of claim 72 is the system of claim 32 further comprising code for generating untargeted incentives offered by manufacturers or retailers (page 21 lines 14-19).

The invention of claim 73 is the system of claim 32 wherein said purchase incentives contain data enabling coupons to be printed by said consumer (page 19 lines 8-12).

The invention of claim 74 is the system of claim 32 wherein said purchase incentives contain data enabling purchase incentives to be printed at point of sale (page 24 lines 21-24).

The invention of claim 75 is the system of claim 32 further comprising means to encode in a consumer's identification card, tokens representing said purchase incentives (page 24 lines 9-15).

The invention of claim 76 is the method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises shopping list selections associated with a particular consumer (page 14 lines 13-20).

The invention of claim 77 is the method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises rebate offers data associated with a particular consumer (page 12 line 21).

The invention of claim 78 is the method of claim 50 wherein said online shopping activity stored in said consumer purchase history database in association with an identification for a particular consumer comprises data detailing notice of specific offers provided to said particular consumer (page 21 lines 27-29).

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The invention of claim 79 is the method of claim 50 further comprising generating focused incentives for a consumer based on said consumer's prior shopping activity (page 19 lines 25-26).

The invention of claim 80 is the method of claim 50 further comprising generating purchasing incentives data in a form suitable for printing of a coupon by a consumer (page 21 lines 8-10).

The invention of claim 81 is the method of claim 50 further comprising generating links to at least one of manufacturer and retailer web sites and associating said links with a particular consumer (page 15 lines 18-20).

The invention of claim 82 is the method of claim 50 further comprising enabling a consumer to request at least one of information regarding a product and a sample of a product (page 12 line 22 and page 12 line 25).

The invention of claim 83 is the method of claim 50 wherein said consumer purchase history database stores data from an administrator of said system's web site (page 20 lines 28-30).

The invention of claim 84 is the method of claim 50 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands (page 6 lines 17-23 and page 23 lines 8-9).

The invention of claim 85 is the method of claim 50 wherein said consumer purchase history database stores at least three of said customer identification number, name, residential address, zip code, and email address (page 14 line 27 through page 15 line 1 and page 19 lines 22-23).

The invention of claim 86 is the method of claim 50 wherein said consumer purchase history database stores selected consumer demographic information, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household (page 14 line 27 through page 15 line 1).

The invention of claim 87 is the method of claim 50 wherein said purchase incentives include targeted, time phased incentives based on a consumer's actual buying patterns and preferences (page 21 lines 10-13).

The invention of claim 88 is the method of claim 50 wherein said purchase incentives include untargeted incentives from at least one of manufacturers and retailers (page 21 lines 14-19).

The invention of claim 89 is the method of claim 50 further comprising printing said purchase incentives on a printer connected to and controlled by a consumer's computer (page 21 lines 8-9).

The invention of claim 90 is the method of claim 50 further comprising printing purchase incentives at point of sale (page 24 lines 21-24).

The invention of claim 91 is the method of claim 50 further comprising encoding in a consumer's identification card tokens representing said purchase incentives (page 24 lines 9-15).

F.   **37 CFR 41.37(c)(1)(vi) Grounds of Rejection to be Reviewed on Appeal**

Whether the rejections of claims 32-56 and 59-91 under 35 USC 102(e) based upon Jovicic et al. (US 5,855,007) [hereinafter Jovicic] are improper and should be reversed.

G.   **37 CFR 41.37(c)(1)(vii) Argument**

1.   **Rejections of Claims Under 35 USC 102(e) of Claims 32-56 and 57-91 as Being Anticipated by Jovicic et al. (US 5,855,007)**

a.   **The Examiner's Argument**

In support of the rejections of claims 32-91 under 35 USC 102(e), the examiner asserts that:

Claims 32-56 and 58-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Jovicic et al. (US 5,855,007). Jovicic is considered to disclose a system or method comprising:

a web site for providing purchasing incentives from multiple sources (column 6 lines 4-48 wherein the disclosed Internet coupon notification center is considered to be patentably equivalent to the claimed multiple source web site purchase incentive);

a consumer purchase history database based on consumer online shopping activity (column 6 line 61 through column 7 line 61 wherein the disclosed

electronic coupon redemption center accounting purpose is considered to implicitly anticipate claimed online purchase history database because redemption implies purchase history and accounting implies database shopping activity, column 7 line 66-67 expressly teaches the claimed online shopping purchase history because the disclosed shopping patterns of a particular user is considered to be based on shopping purchase history, and column 9 lines 19-28 wherein the disclosed past transaction recordation of coupon server database access implies an online consumer purchase history database because coupons associated with online shopping indicate history as claimed);

a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said web site so as to receive consumer data from said web site (column 6 line 58 wherein the disclosed customer internet address is considered to anticipate the claimed consumer e-mail address because based on applicants' specification, it would be reasonable to broadly construe the terms as patentably synonymous and column 7 line 36 wherein the disclosed customer internet address or claimed consumer e-mail address is considered to be stored in a database);

receiving a consumer's e-mail address from a consumer's computer (column 8 lines 18-22 wherein the disclosed user self e-mailing is considered to expressly teach to consumer e-mail receipt);

maintaining a consumer email database which can identify consumers by their e-mail address (column 6 line 58 wherein the disclosed customer internet address is considered to anticipate the claimed consumer e-mail address because based applicants' specification, it would be reasonable to broadly construe the terms as patentably synonymous);

formatting an e-mail message to a consumer by electronic mail for subsequent printing of a coupon (column 7 lines 45-55 wherein the disclosed internet coupon server electronic mail print out is considered to expressly anticipate the claimed e-mail formatting for coupon printing); and/or

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means for delivering purchasing incentives or notices to purchase a specific manufacturer product to consumers by e-mail or means for delivering e-mail notices which remind consumers to visit the web site or transmitting purchase incentives via an e-mail post office or transmitting to consumers a notice to visit the web site via the consumer email address or generating targeted purchase incentives from a consumer purchase history database (column 7 lines 40-45 wherein the disclosed electronic mail message communication is considered to expressly disclose the claimed delivery means, reminder means, transmitting method, or generating method). Jovicic is also considered to disclose the claimed consumer profile (column 6 line 59), purchase history and consumer database integration (column 8 line 7), independently administered web site (column 10 line 34), cooperative site (column 10 line 36), past purchasing activity (column 7 line 66), shopping list selection data (column 8 line 50), rebate offer data (column 2 line 37), manufacturer or retailer web site links (column 7 line 58), product or sample information request (column 7 line 65), consumer favorite brands (column 6 line 59), customer identification number or name storage (column 7 line 27), demographic information (column 1 line 63), targeted time phased incentives based on consumer actual buying patterns and preferences (column 8 line 19), generating untargeted incentives (column 1 line 61), printed data enabling coupons (column 7 line 47), point of sale printing (column 2 line 64), token encoding identification card (column 7 line 27), shopping list selections (column 6 line 50), and particular consumer specific offers (column 6 line 60). [Office action mailed May 4, 2004 page 2 line 5 through page 5 line 7.]

b.   The Applicants' Response

In reply, the applicants respectfully submit that rejections of claims 32-56 and 58-91 under 35 USC 102(e) based upon Jovicic are improper and should be reversed because (1) these rejections are not supported by substantial evidence and (2) these rejections fail to carry the burdens of proof and persuasion.

1. **Claims 32, 38, 44, 50, 54, and Dependent Claims 33-37,
39-43, 45-49, 51-53, 55-56, and 59-91 "a web site for
providing purchasing incentives from *multiple sources*"**

The examiner asserts that "Jovicic is considered to disclose a system or method comprising a web site for providing purchasing incentives from multiple sources". The examiner further asserts that "...the disclosed internet coupon notification center is considered to be patentably equivalent to the claimed multiple source web site purchase incentive." In summary reply, the applicant submits that Jovicic's "internet coupon notification center" is not the claimed "web site for providing purchasing incentives from multiple sources," as will be shown below.

In support of the assertion that "Jovicic is considered to disclose a system or method comprising a web site for providing purchasing incentives from multiple sources", the examiner cites column 6 lines 4-48 in Jovicic, which states that:

As shown in FIG. 1, the Internet node 102 is coupled to an Internet Coupon Server 124 via Internet 122. The Internet Coupon Server 124 is any general purpose digital computer which serves as an "Internet Host" as described in the Internet Protocol RFC 791, and contains electronic coupons 300 and would preferably include a user database 126 which would keep track of the individual users registered with the Internet Coupon Server, a browsing memory 128 where representative coupon or coupons are stored and ready for selection by users, and a coupon database 130 which will be more fully discussed below. In addition, The Internet Coupon Server 124, also includes Internet Coupon Notification Center Gateway 132 (ICNC gateway) for communicating with a plurality of Internet Coupon Notification Centers (ICNC) 134. The ICNC gateway 132 preferably also includes a computer database identifying interfacing information for accessing one or more ICNCs 134 through the interface. ICNC 134 could be either communicating with the ICNC gateway 132 over public computer network such as the Internet 122, as shown in FIG. 1 or physically present within the Internet Coupon Server. Each ICNC 134 is the owner of one particular category of coupons, for example a "Ben & Jerry's Inc." coupon category which gives $0.25

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discount on "Ben & Jerry's Vanilla Bean Ice Cream", and could comprise a coupon generation data base 136 for storing data about electronic coupons generated by the Internet Coupon Server 124, a coupon redemption database 138 for storing data about electronic coupons redeemed by users, general message database 140 for storing messages of general nature, and optionally, a printing device which records coupon transactions. Periodically, the ICNC 134 can communicate with the Internet Coupon Server 124, such as by the Internet Coupon Notification Center Gateway 132, and update Internet Coupon Server's Coupon Database 130, regarding the discount value of the coupon, number of coupons available, and coupon specifications. In this way, the Internet Coupon Server can maintain current information on electronic coupons 300 available to consumers. Typically, these consumers would be users of computing devices that are connected into public computer networks such as the Internet 122. As new providers of coupons become members of the electronic coupon communication system 100, they can establish ICNCs 134 and make their electronic coupons available to consumers over the Internet Coupon Server 124.

For at least the following reasons, the applicants submit that the cited passage in Jovicic does not disclose or suggest "a web site for providing purchasing incentives from *multiple sources*," as recited by claims 32, 38, 44, 50, and 54.

As to the meaning of "multiple sources", this application states at page 3 lines 12-16 that:

> The purchasing incentive offers in the presently preferred embodiment of the invention are derived from two sources: product manufacturers and retailers. The manufacturers' incentives are presented to the customer in the form of a convenient index that the customer can browse through and select from. Similarly, retail supermarkets provide the source of another set of special offers, organized by store.

In addition, respecting both the Figure 1 and 13 embodiments, the specification states at page 18 lines 27-29 that:

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A user 308 logs on to the server 300 through the network 304 and selects from a variety of offers stored on the storage device 306 by manufacturers and retailers.

Thus, the specification defines "multiple sources" to mean multiple retailers and/or manufacturers.

In contrast, Jovicic discloses its internet coupon notification center means an "internet coupon notification center" is not "owner of a *particular category* of coupons". Jovicic column 6 lines 24-25. Therefore, Jovicic's disclosed "web site for providing purchasing incentives from *multiple sources*" as defined by independent claims 32, 38, 44, 50, and 54. Therefore, independent claims 32, 38, 44, 50, and 54 patentably define over Jovicic. Therefore, the rejections of independent claims 32, 38, 44, 50, and 54 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

Dependent claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 depend from independent claims 32, 38, 44, 50, or 54. The rejections of dependent claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 under 35 USC 102(e) as being anticipated by Jovicic are improper for the reasons presented for the independent claims and should be reversed.

> 2. **Claims 32, 38, 44, 50, 54, and Dependent Claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 "a consumer purchase history database" and "online shopping activity"**

The examiner asserts that Jovicic is considered to disclose a system or method comprising "a consumer purchase history database based on consumer online shopping activity". The examiner further asserts that "wherein the disclosed electronic coupon redemption center accounting purpose is considered to implicitly anticipate the claimed online purchase history database because redemption implies purchase history and accounting implies database shopping activity". The examiner is referring to Jovicic. In summary reply, the applicant submits that Jovicic discloses, with respect to databases, only that the user inputs demographic information during the initial process. As shown below, Jovicic does not disclose either (1) a consumer

purchase history database or a database (2) based on consumer online shopping activity, as will be shown below.

The examiner cites column 6 line 61 through column 7 line 61 in Jovicic as allegedly disclosing that Jovicic is considered to disclose a system or method comprising "a consumer purchase history database based on consumer online shopping activity", which states that:

> The electronic coupon 300 also includes the product title 304 which bears indicia identifying the product to which the coupon applies, owner's title 306 which bears indicia identifying a particular person or company participating in the electronic coupon communication system 100, as well as the owner's coupon specification data 308 which bears indicia that communicate the coupon owner's instructions to the consumer and the coupon redemption center, regarding coupon redemption. Uniform product code 310 bears the standardized product code provided to the electronic coupon communication system 100 by the coupon's owner which serves his or her own accounting purposes. Similarly, digital representation of a graphical image of a bar code 312 is a standardized machine readable code provided to the electronic coupon communication system 100 by the coupon's owner which serves his or her own accounting purposes. Expiration date 314 bears indicia indicating the expiration date of the coupon (if any). Furthermore, digital representation of a graphical image of the product 316 could bear a symbol, logo or an image related to the product graphically identifying the product. In addition, digital representation of the bar code's 312 and the product's 316 graphical image could utilize any of the image compression algorithms commonly used by general computing devices, such as the Joint Photographic Expert Group (JPEG) algorithm. Furthermore, electronic coupon 300 also contains a unique coupon serial number 318 generated by a coupon generation process 410 which identifies each particular electronic coupon 300 and plays an important role in marketing research and micro marketing techniques utilized by the coupon's owner. In the preferred embodiment of the invention, the electronic coupon 300 also contains customer's name data 320 bearing indicia pertaining to the name of coupon's user, customer's identification number (I.D.) 322 bearing

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customer I.D. assigned to the user by the Internet Coupon Server 124 during a registration process 408 having the customer's Internet address 324 and a personalized message 326 which bears a marketing message generated during the coupon generation process. Indicia pertaining to the coupon 302, 304, 306, 308, 310, 312, 314, 316 and 318 are stored in the coupon data base 130 before the coupon generation process 410 occurs. Indicia pertaining to customer's personal information 320, 322, 324 and 326 are stored in the user data base 126 before beginning the coupon generation process 410. After the coupon generation process 410, all indicia are stored, combined in the browsing memory 128 to represent an electronic coupon 300.

An electronic coupon 300 communicates a message to the user of the Internet node 102 when, for example, displayed on a viewing display 116 during the on-line session or stored in memory in the form of electronic mail 120, or when printed as a hard copy on user's printer 118.

A person can select an electronic coupon 300 from the Internet Coupon Server 124, print out a hard copy and redeem it at the coupon redemption center 142 (retail outlet) or the user could send the coupon using electronic mail from the Internet Coupon Server 124 directly to the redemption center's general computing device connected into public computer network such as the Internet 122. The redemption center 142 would have an option to verify the legitimacy of the electronic coupon 300 by contacting coupon owner's ICNC 134 using various communication means.

According to the present invention, user's general computing device connected to the public network such as the Internet 122, establishes an on-line session with the Internet Coupon Server 124, preferably goes through the registration process 408 if the user is a new user, and then, after the coupon generation process 410 described in detail below,...

The examiner also states that "column 7 lines 66-67 expressly teaches the claimed online shopping purchase history because the disclosed shopping patterns of a particular user is considered to be based on shopping purchase history, and column 9 lines 19-28 wherein the

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disclosed past transaction recordation of coupon server database access implies an online consumer purchase history database because coupons associated with online shopping indicate history as claimed".

Column 7 lines 65-67 states that:

> In the preferred embodiment of the invention, browsing is customized so that it suits the needs and shopping patterns of a particular user. By entering user input, such as through...

Column 9 lines 19-28 states that:

> If the expiration date was not exceeded, the Internet Coupon Server records the transaction 510 in the field 11 which contains past transactions, by first storing customer's name, then customer's identification number and then the current coupon serial number. After the transaction is recorded, the Internet Coupon Server 124 notifies the transaction 512 over the Internet Coupon ICNC gateway to the coupon owner's ICNC 134 by first sending customer's name 320, then customer's identification number 322 and then the current coupon serial number 318.

For at least the following reasons, the applicants submit that the cited passages in Jovicic do not disclose or suggest either (1) "a consumer purchase history database based on consumer online shopping activity", as recited by claims 32, 38, 44, and 50; or (2) "maintaining a consumer purchase history database based on consumer online shopping activity", as recited by claim 54.

Jovicic discloses, with respect to databases, only that the user inputs demographic information during the initial registration process. See column 9 lines 60-63, which states that:

> Field 5 [Defined as "User demographic information" in Table 2 in Jovicic column 9 line 48.] bears indicia identifying user's demographic information which the Internet Coupon Server receives from the user during the initial registration process. [Jovicic column 9 lines 60-63.]

This registration information does not include either purchase information or online shopping activity. Moreover, Jovicic discloses demographics to mean region data or responses

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to marketing surveys, not purchase history information. Column 1 line 63 through column 2 line 1 of Jovicic states that:

> While some demographic information can be obtained by noting the geographical regions in which the coupons were redeemed, the lack of any specific information as to the nature of the purchaser leads many manufacturers to conduct separate marketing surveys which are extremely costly and time consuming.

Moreover, Jovicic's other teachings are inconsistent with the examiner's conclusions as to Jovicic's teachings. The object of the invention, column 3 lines 1-6 in Jovicic, states that:

> [T]o provide a coupon distribution and redemption system which can identify users of the system before they make coupon selections and offer different coupons to different users of the system before they make coupon selections on the basis of already-obtained demographic data about the users.

Thus, Jovicic is clearly directed to providing coupons, not purchases. Therefore, Jovicic does not disclose a consumer purchase history database.

Therefore, Jovicic does not disclose storing consumer purchase information. Accordingly, Jovicic does not disclose "a consumer purchase history database based on consumer online shopping activity", as recited by independent claims 32, 38, 44 and 50; and "maintaining a consumer purchase history database based on consumer online shopping activity", as recited by independent claim 54. Therefore, the rejections under 35 USC 102(e) based upon Jovicic are improper.

Since claims 32-56 and claims 58-91 either recite a "consumer purchase history database" or depend from a claim that recites a "consumer purchase history database", the rejections of claims 32-56 and claims 58-91 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

3. **Claims 32, 38, 44, 50, 54, and Dependent Claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 "a consumer database which can identify consumers by their e-mail address"**

The examiner asserts that Jovicic is considered to disclose a system or method comprising "a consumer database which can identify consumers by their e-mail address".

The examiner further asserts that "the disclosed customer internet address is considered to anticipate the claimed consumer e-mail address because based on applicants' specification, it would be reasonable to broadly construe the terms as patentably synonymous," and "the disclosed customer internet address or claimed consumer e-mail address is considered to be stored in a database". In summary reply, the applicant submits that Jovicic does not disclose a consumer database which can identify consumers by their e-mail address. Jovicic only discloses (1) that the user may be prompted to enter an email address and (2) that the Internet Coupon Server 124 mails the coupon electronically to the user, as will be shown below. What the examiner incorrectly assumed meant an email address (customer's internet address) is in fact a network address, not an email address. See Attachment 1.

In support of the assertion that Jovicic is considered to disclose a system or method comprising "a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said website so as to receive consumer data from said website", the examiner cites column 6 line 58 in Jovicic, which states that:

... number 322, customer's Internet address 324, and ...

In further support of the assertion that Jovicic is considered to disclose a system or method comprising "a consumer database which can identify consumers by their e-mail address, wherein said consumer database is connected to said website so as to receive consumer data from said website", the examiner cites column 7 line 36 in Jovicic, which states that:

... customer's personal information 320, 322, 324, and 326 are stored ...

For at least the following reasons, the applicants submit that Jovicic does not disclose or suggest "a consumer database which can identify consumers by their e-mail address", as recited by claims 32, 38, 44, 50, and 54.

Jovicic indicates that its server does <u>not</u> store user email addresses (1) by teaching in its

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preferred embodiment that the user may be prompted to enter an email address during an online session so that the Internet Coupon Server 124 can e-mail the coupon electronically to the user. See column 8 lines 10-17, which states that:

> Once the user viewing the display 116 selects an electronic coupon 300 being displayed, such as by entering user input at the keyboard 114, the Internet Coupon Server 124 may ask the user to choose if the coupon is to be mailed

electronically, Internet Coupon Server 124 prompts the user to input an electronic mail address 418. When electronic mail address is inputed [sic], Internet Coupon Server 124 mails the coupon electronically to the addressee 420.

This indicates that Jovicic's server does not have an email stored in association with the user log in name in user database 126. This means that Jovicic does not disclose a "consumer database which can identify consumers by their e-mail address".

Jovicic indicates that its server does not store user email addresses (2) by disclosing the user database 126 fields, none of which stores a user email address, stating in Table 2 that the user data structure fields only include user name, user login name, user password, user identification number, user demographic information, and user customized message. Jovicic column 9 lines 42-50.

Moreover, Jovicic uses the term "customer's Internet address", which does not mean an email address. The term "internet address" is defined to mean "The 32-bit host address defined by the Internet Protocol in STD 5, RFC 791. It is usually represented in dotted decimal notation", which is not an email address. See Attachment 1, which is a copy of the definition of internet address, "Dictionary.com, http://dictionary.reference.com/search?q=internet%20address".[1]

Column 7 lines 27-32 of Jovicic refers to the customer internet address, stating that:

> ... customer's identification number (I.D.) 322 bearing customer I.D. assigned to the user by the Internet Coupon Server 124 during a registration process 408 having the customer's Internet address 324 and a personalized

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[1] Attachment 1 is a copy of the definition of internet address, "Dictionary.com, http://dictionary.reference.com/search?q=internet%20address".

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message 326 which bears a marketing message generated during the coupon generation process.

Thus, contrary to the examiner's position, one of ordinary skill in the art would have recognized that Jovicic's reference to a customer's internet address meant an internet address. Therefore, Jovicic does not disclose identifying consumers by their e-mail addresses.

Therefore, Jovicic does not disclose "maintaining a consumer email database which can identify consumers by their e-mail address", as recited by claim 50; and Jovicic does not disclose "maintaining a consumer database which can identify consumers by their e-mail address", as recited by claim 54. Therefore, the 35 USC 102(e) rejections based upon Jovicic are improper. Therefore, the rejections of claims 50 and 54 under 35 USC 102(e) as being anticipated by Jovicic should be reversed.

Dependent claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 depend from independent claims 32, 38, 44, 50, or 54. The rejections of dependent claims 33-37, 39-43, 45-49, 51-53, 55-56, and 59-91 under 35 USC 102(e) as being anticipated by Jovicic are improper for the reasons presented for the independent claims and should be reversed.

4. Claims 38, 54, and Dependent Claims 39-43 and 55-56 "means for delivering e-mail notices which remind consumers to visit the web site"

The examiner asserts that "Jovicic is considered to disclose a system or method comprising means for delivering e-mail notices which remind consumers to visit the web site". The examiner further asserts that "the disclosed electronic mail message communication is considered to expressly disclose the claimed delivery means, reminder means, transmitting method, or generating method". However, Jovicic does not disclose the content of the message. In support of the statement that "Jovicic is considered to disclose a system or method comprising means for delivering e-mail notices which remind consumers to visit the web site", the examiner cites column 7 lines 40-45 in Jovicic, which states that:

> An electronic coupon 300 communicates a message to the user of the
> Internet node 102 when, for example, displayed on a viewing display 116 during
> the on-line session or stored in memory in the form of electronic mail 120, or

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when printed as a hard copy on user's printer 118.

For at least the following reasons, the applicants submit that the cited passage in Jovicic does not disclose or suggest (1) the content of the message, which is recited by the limitation "a means for delivering by e-mail notices which remind consumers to visit said Web site", as recited in claim 38, or (2) the content of the message, which is recited by the limitation "transmitting to consumers a notice to visit the Web site via the consumer's post office", as recited in claim 54.

Jovicic does not disclose the content of the message and therefore, Jovicic does not disclose sending a notice to visit said Web site or to visit the Web site via the consumer's post office. Moreover, Jovicic discloses that the electronic coupon is "stored in memory in the form of electronic mail 120", however, Jovicic does not disclose the delivery means or transmitting method of this email message.

Therefore, Jovicic does not disclose "a means for delivering by e-mail notices which remind consumers to visit said Web site", as recited by claim 38; and Jovicic does not disclose "transmitting to consumers a notice to visit the Web site via the consumer's post office", as recited by claim 54. Therefore, the rejections of independent claims 38 and 54 under 35 USC 102(e) based upon Jovicic are improper and should be reversed.

Dependent claims 39-43 and 55-56 depend from independent claims 38 or 54. The rejections of dependent claims 39-43 and 55-56 under 35 USC 102(e) as being anticipated by Jovicic are improper for the reasons presented for the independent claims and should be reversed.

5.   **Claim 54 and Dependent Claims 55-56 "transmitting to consumers a notice to visit the web site via the consumer email address"**

The examiner asserts that "Jovicic is considered to disclose a system or method comprising means for transmitting to consumers a notice to visit the web site via the consumer email address". The support cited by the examiner is the same as that contained in section III.H.3.a.2.(d) above.

The applicants submit that the cited passage in Jovicic does not disclose or suggest the

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content of the message, which is recited by the limitation "transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office", as recited in claim 54.

Therefore, the rejection of independent claim 54 under 35 USC 102(e) as being anticipated by Jovicic is improper and should be reversed.

Dependent claims 55-56 depend from independent claim 54. The rejections of dependent claims 55-56 under 35 USC 102(e) as being anticipated by Jovicic are improper for the reasons presented for the independent claim 54 and should be reversed.

6. Claims 34, 40, and 46 - The Claimed "purchase history and consumer database are integrated"

The examiner asserts that "Jovicic is considered to disclose the claimed purchase history and consumer database integration". In support of this assertion, the examiner cites column 8 line 7 in Jovicic, which states that:

... Coupon Server 124 sequentially transmit digitized pattern of ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "purchase history and consumer database integration", which is defined by claims 34, 40, and 46.

As proven above, Jovicic does not disclose a consumer purchase history database. Therefore, Jovicic does not disclose the claimed "purchase history and consumer database integration", as defined by claims 34, 40, and 46. Therefore, the rejections of claims 34, 40, and 46 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

7. Claims 35, 41, 47, 52, 55, 67, and 83 - The Claimed independently administered web site

The examiner asserts that "Jovicic is considered to disclose the claimed independently administered web site". In support of this assertion, the examiner cites column 10 line 34 in Jovicic, which states that:

... invention, the Internet node 102 will access Internet Coupon ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "independently administered web site", which is defined by claims 35,

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41, 47, 52, 55, 67, and 83.

The claimed independently administered web site is disclosed, for example, at page 5 line 28 through page 6 line 2 of the subject application, which states that:

> Instead of being administered by or for a single commercial entity, the Web site through which customers communicate in accordance with the present invention is a cooperative site involving both retailers and manufacturers, to provide customers with a variety of information, planning aids, and shopping incentives from multiple sources.

The passage that the examiner cites does not disclose the administration of a web site, it discloses the interaction between the Internet node 102 and the Internet Coupon Server's browsing memory 128 during the on-line session.

Jovicic does not disclose the claimed "independently administered web site", as defined by claims 35, 41, 47, 52, 55, 67, and 83. Therefore, the rejections of claims 35, 41, 47, 52, 55, 67, and 83 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

8. Claims 36, 42, and 48 - The Claimed "cooperative site"

The examiner asserts that "Jovicic is considered to disclose the claimed cooperative site". In support of this assertion, the examiner cites column 10 line 36 in Jovicic, which states that:

> ... over public computer network such as the Internet 122 using ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "cooperative site", which is defined by claims 36, 42, 48, 53, and 56.

The passage that the examiner cites does not disclose the claimed cooperative site, it discloses an interaction between the Internet node 102 and the Internet Coupon Server's browsing memory 128 during the on-line session. The use of a "public computer network such as the Internet" does not disclose a cooperative site.

The claimed "cooperative site" is disclosed, for example, at page 5 line 28 through page 6 line 2 in the subject application, which states that:

> Instead of being administered by or for a single commercial entity, the Web site through which customers communicate in accordance with the present invention is a cooperative site involving both retailers and manufacturers, to

provide customers with a variety of information, planning aids, and shopping incentives from multiple sources.

Jovicic does not disclose the claimed "cooperative site", as defined by claims 36, 42, 48, 53, and 56. Therefore, the rejections of claims 36, 42, 48, 53, and 56 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

9. Claims 53 and 56 - The Claimed "step of providing a web site is achieved cooperatively"

The examiner asserts that Jovicic is considered to disclose the claimed "step of providing a web site is achieved cooperatively." In support of this assertion, the examiner cites column 10 line 36 in Jovicic, which states that:

> ... over public computer network such as the Internet 122 using ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "step of providing a web site is achieved cooperatively", which is defined by claims 53 and 56.

The passage that the examiner cites does not disclose the claimed "step of providing a web site is achieved cooperatively", it discloses an interaction between the Internet node 102 and the Internet Coupon Server's browsing memory 128 during the on-line session. The use of a "public computer network such as the Internet" does not disclose the claimed "step of providing a web site is achieved cooperatively".

The claimed "step of providing a web site is achieved cooperatively" is disclosed, for example, at page 5 line 28 through page 6 line 2 in the subject application, which states that:

> Instead of being administered by or for a single commercial entity, the Web site through which customers communicate in accordance with the present invention is a cooperative site involving both retailers and manufacturers, to provide customers with a variety of information, planning aids, and shopping incentives from multiple sources.

This passage discloses that both retailers and manufacturers are able to combine their efforts, including information and incentives, to provide a beneficial website for customers, as defined in claims 53 and 56.

Jovicic does not disclose the claimed "step of providing a web site is achieved cooperatively", as recited by claims 53 and 56. Therefore, the rejections of claims 53 and 56 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

10. Claims 37, 43, and 49 - The Claimed "past purchasing activity"

The examiner asserts that "Jovicic is considered to disclose the claimed past purchasing activity". In support of this assertion, the examiner cites column 7 line 66 in Jovicic, which states that:

> ... customized so that it suits the needs and shopping patterns ...

In reply, the applicants submit that the passage that the examiner cites in Jovicic does not disclose or suggest the claimed "past purchasing activity", which is defined by claims 37, 43, and 49.

The passage cited by the examiner is taken out of the context of the disclosure. Column 7 line 65 through column 8 line 2 in Jovicic states that:

> In the preferred embodiment of the invention, browsing is customized so
> that it suits the needs and shopping patterns of a particular user. By entering user
> input, such as through the keyboard 114, the user can browse through the
> available coupons and make a selection of one coupon 300.

The passage discloses that the user has to enter input to customize the browsing, not that the user's past purchasing activity is involved.

Jovicic does not disclose the claimed "past purchasing activity", as defined by claims 37, 43, and 49. Therefore, the rejections of claims 37, 43, and 49 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

11. Claim 76 - The Claimed "shopping list selection data"

The examiner asserts that "Jovicic is considered to disclose the claimed shopping list selection data". In support of this assertion, the examiner cites column 8 line 50 in Jovicic, which states that:

> Structure (Table 1). Field 1 "Number of coupons available" ...

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In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "shopping list selection data", which is defined by claim 76.

Column 8 lines 48-53 in Jovicic states that:

> Upon coupon selection 412, the transaction is recorded in the coupon data base 130, said data base containing Coupon Structure (Table 1). Field 1 "Number of coupons available" bears indicia providing information on the maximum number of electronic coupons the current unique coupon serial number 318 which makes a particular coupon unique.

This passage discloses information presented to the consumer <u>after</u> coupon selection, which does not disclose the claimed shopping list selection data. Moreover, the information in the Jovicic disclosure pertains to the number of coupons available, while shopping list selection data is disclosed in the subject application to present to the consumer such variables as store department and selected items within that department before the consumer makes a selection.

Jovicic does not disclose the claimed "shopping list selection data", as defined by claim 76. Therefore, the rejection of claim 76 under 35 USC 102(e) as being anticipated by Jovicic is improper and should be reversed.

12.   Claims 60 and 77 - The Claimed "rebate offer data"

The examiner asserts that "Jovicic is considered to disclose the claimed rebate offer data". In support of this assertion, the examiner cites column 2 line 37 in Jovicic, which states that:

> ... clearing, e) eliminate fraudulent redemptions of the type that ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "rebate offer data", which is defined by claims 60 and 77.

The passage cited by the examiner relates to the redemption of coupons. Jovicic does not disclose the claimed "rebate offer data", as defined by claims 60 and 77. Therefore, the rejections of claims 60 and 77 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

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13. **Claims 64 and 81 - The Claimed "manufacturer or retailer web site links"**

The examiner asserts that "Jovicic is considered to disclose the claimed manufacturer or retailer web site links". In support of this assertion, the examiner cites column 7 line 58 in Jovicic, which states that:

> Internet 122, establishes an on-line session with the Internet Coupon
> Server 124...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "manufacturer or retailer web site links", which is defined by claims 64 and 81.

The Internet Coupon Server 124 is defined in Jovicic at column 6 lines 5- 8, which states that:

> The Internet Coupon Server 124 is any general purpose digital computer
> which serves as an "Internet Host" as described in the Internet Protocol RFC 791.

Jovicic also discloses on column 6 lines 14-25 that the Internet Coupon Server 124 includes Internet Coupon Notification Center Gateway 132 and that each Internet Coupon Notification Center Gateway communicates with a plurality of Internet Coupon Notification Centers 134, each of which are the owners a particular coupon category. However, Jovicic does not disclose the claimed "manufacturer or retailer web site links", as defined by claims 64 and 81. Therefore, the rejections of claims 64 and 81 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

14. **Claims 65 and 82 - The Claimed "product or sample information request"**

The examiner asserts that "Jovicic is considered to disclose the claimed product or sample information request". In support of this assertion, the examiner cites column 7 line 65 in Jovicic, which states that:

> In the preferred embodiment of the invention, browsing is ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "product or sample information request", which is defined by claims 65

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and 82.

This passage discloses that the user has to enter input to customize the browsing and does not disclose the claimed "product or sample information request", as defined by claims 65 and 82. Therefore, the rejections of claims 65 and 82 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

15. **Claims 68 and 84 - The Claimed "consumer favorite brands"**

The examiner asserts that "Jovicic is considered to disclose the claimed consumer favorite brands". In support of this assertion, the examiner cites column 6 line 59 in Jovicic, which states that:

... personalized message tailored to a particular customer.

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "consumer favorite brands", which is defined by claims 68 and 84.

The passage cited in Jovicic discloses the inclusion of a personalized message in an electronic coupon. However, Jovicic does not disclose that its system is capable of retaining a consumer's favorite brands. Therefore, the personalized message could not contain a consumer's favorite brands, as disclosed in claims 68 and 84.

Jovicic does not disclose the claimed "consumer favorite brands", as defined by claims 68 and 84. Therefore, the rejections of claims 68 and 84 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

16. **Claims 69 and 85 "said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address"**

The examiner asserts that "Jovicic is considered to disclose the claimed customer identification number or name storage". In support of this assertion, the examiner cites column 7 line 27 in Jovicic, which states that:

... coupon's user, customer's identification number (I.D.) 322 ...

In reply, the applicants submit that even if Jovicic disclosed a system or method comprising the claimed "customer identification number or name storage", Jovicic would not disclose "said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address", which is defined by claims 69 and 85.

As proven above, Jovicic does not disclose a consumer purchase history database. Moreover, the "customer identification number and customer name" that the examiner claims is disclosed by Jovicic do not total the minimum three required elements as disclosed in claims 69 and 85.

Therefore, Jovicic does not disclose the claimed "said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address", as defined by claims 69 and 85. Therefore, the rejections of claims 69 and 85 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

> 17. **Claims 70 and 86 "said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household"**

The examiner asserts that "Jovicic is considered to disclose the claimed demographic information". In support of this assertion, the examiner cites column 1 line 63 in Jovicic, which states that:

> While some demographic information can ...

In reply, the applicants submit that even if Jovicic disclosed a system or method comprising the claimed "demographic information", Jovicic would not disclose "said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household", which is defined by claims 70 and 86.

As proven above, Jovicic does not disclose a consumer purchase history database. Moreover, the "demographic information" that the examiner claims is disclosed by Jovicic do

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not total the minimum two required elements as defined in claims 70 and 86.

Therefore, Jovicic does not disclose the claimed "said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household", as defined by claims 70 and 86. Therefore, the rejections of claims 70 and 86 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

18. **Claims 71 and 87 - The Claimed "targeted time phased incentives based on consumer actual buying patterns and preferences"**

The examiner asserts that "Jovicic is considered to disclose the claimed targeted time phased incentives based on consumer actual buying patterns and preferences". In support of this assertion, the examiner cites column 8 line 19 in Jovicic, which states that:

... choose to e-mail the coupon to him or herself allowing him ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "targeted time phased incentives based on consumer actual buying patterns and preferences", which is recited by claims 71 and 87.

The passage cited by the examiner discloses that a consumer, who is viewing a display of electronic coupons, can email the coupon to the consumer. This passage does not disclose targeted incentives, time-phased incentives, and the incentives are not based on consumer actual buying patterns and preferences; all of which are disclosed, for example, by the subject application at page 21 lines 10-13, which states that:

This approach allows producing targeted, time-phased incentives based on the customer's actual buying patterns and preferences, and delivering them in the home prior to the customer's shopping trip.

Jovicic does not disclose the claimed "targeted time phased incentives based on consumer actual buying patterns and preferences", as defined by claims 71 and 87. Therefore, the rejections of claims 71 and 87 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

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19. **Claims 72 and 88 "generating untargeted incentives"**

The examiner asserts that "Jovicic is considered to disclose the claimed generating untargeted incentives". In support of this assertion, the examiner cites column 1 line 61 in Jovicic, which states that:

> ... submitted anonymously, the manufacturer does not know ...

In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest the claimed "generating untargeted incentives", which is recited by claims 72 and 88.

The passage, in the Background of the Invention section, refers to the practice that coupons were submitted anonymously to consumers and the manufacturer did not know who had redeemed coupons, so the manufacturer could not market to the redeemers. This passage does not disclose "generating untargeted incentives", which is disclosed, for example, by the subject application at page 21 lines 14-19, which states that:

> The same delivery mechanism can be used to deliver untargeted or less
> targeted incentives from manufacturers, indicated at 518. The manufacturers
> may, for example, generate weekly offers, as shown in block 520, which the
> system delivers to selected consumers. Selection of consumers may be based on a
> customer profile or on demographic information maintained by the system
> administrator and selected by the manufacturer.

Jovicic does not disclose the claimed "generating untargeted incentives", as defined by claims 72 and 88. Therefore, the rejections of claims 72 and 88 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

20. **Claims 75 and 91 - The Claimed "token encoding identification card"**

The examiner asserts that "Jovicic is considered to disclose the claimed token encoding identification card". In support of this assertion, the examiner cites column 7 line 27 in Jovicic, which states that:

> ... coupon's user, customer's identification number (I.D.) 322 ...

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In reply, the applicants submit that the passage that the examiner cites does not disclose or suggest a token and therefore Jovicic does not disclose the claimed "token encoding identification card", which is defined by claims 75 and 91 and is disclosed, for example, by the subject application at page 19 lines 8-12, which states that:

> (b) The server 300 transmits the image of a token 316 of some kind to the
> user's computer 302. The token defines the coupon offer, preferably in coded
> form, such as in bar codes, but is not recognizable as a coupon. The token may,
> for example, be an encoded confirmation number. The user 308 presents the
> token 316 at the store he or she has selected, and receives the appropriate discount
> or promotion automatically.

Therefore, the rejections of claims 75 and 91 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

21.   Claims 59 and 76 - The Claimed "shopping list selections"

The examiner asserts that "Jovicic is considered to disclose the claimed shopping list selections". In support of this assertion, the examiner cites column 6 line 50 in Jovicic, which states that:

> ... preferably a combination of indicia and graphics which
> communicates ...

In reply, the applicants submit that the passage that the examiner cites discloses an electronic coupon. It does not disclose or suggest the claimed "shopping list selections", which is recited by claims 59 and 76 and is disclosed, for example, by the subject application at page 14 lines 13-20, which states that:

> The shopping list maker is entered, as indicated in block 220, from the
> main menu, or from any of other various screens. The user may select a store
> department (block 222), such as meat, produce, and so forth, then select from
> displayed items sold in that department, as indicated in block 224. The selected
> items are added to the session record, as indicated in block 226, before a return is
> made to the main menu, as indicated in block 228. Items may be selected for

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adding to the shopping list whether or not any of the items is subject to a manufacturers' or supermarket special offer. Optionally, manufacturer and retailer offers may be displayed in the appropriate sections to alert the users of specials available.

Jovicic does not disclose the claimed "shopping list selections", as defined by claims 59 and 76. Therefore, the rejections of claims 59 and 76 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

22. Claims 61 and 78 - The Claimed "particular consumer specific offers"

The examiner asserts that "Jovicic is considered to disclose the claimed particular consumer specific offers". In support of this assertion, the examiner cites column 6 line 60 in Jovicic, which states that:

> ... [The] discount information 302 bears indicia identifying a particular [value of the coupon].

In reply, the applicants submit that the passage that the examiner cites discloses does not disclose or suggest the claimed "particular consumer specific offers", which is defined by claims 61 and 78.

As proven above, Jovicic does not disclose a consumer purchase history database. Therefore, Jovicic does not disclose the claimed "said consumer purchase history database comprises notices detailing specific offers data", as defined by claim 61 and 78 and is disclosed, for example, by the subject application at page 21 lines 27-29, which states that:

> Untargeted messages or notices can also be broadcast to large numbers of consumers to encourage them to visit a specific retail store, or to purchase a specific manufacturer's product, or to visit the Web site.

Jovicic does not disclose the claimed "particular consumer specific offers", as defined by claims 61 and 78. Therefore, the rejections of claims 61 and 78 under 35 USC 102(e) as being anticipated by Jovicic are improper and should be reversed.

Claim 61 depends from independent claim 32. Therefore, the rejection of claim 61 should be reversed for the same reasons as those reasons presented for claim 32.

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Claim 78 depends from independent claim 50. Therefore, the rejection of claim 78 should be reversed for the same reasons as those reasons presented for claim 50.

23. **Claims 62, 66, and 79 - The Examiner did not Cite Support for Rejecting Claims 62, 66 and 79**

The examiner did not cite support for rejecting claims 62, 66 and 79, so the examiner's rejections of claims 62 and 79 are improper and should be withdrawn.

24. **Claims 63 and 80 - The Examiner did not Cite Support for Rejecting Claims 63 and 80**

The examiner did not cite support for rejecting claims 63 and 80, so the examiner's rejections of claims 63 and 80 are improper and should be withdrawn.

25. **Claim 89 - The Examiner did not Cite Support for Rejecting Claim 89**

The examiner did not cite support for rejecting claim 89, so the examiner's rejection of claim 89 is improper and should be withdrawn.

H. **37 CFR 41.37(c)(1)(viii) Claim Appendix**

An appendix containing a copy of the claims involved in the appeal is attached as Appendix I.

I. **37 CFR 41.37 (c)(1)(ix) Evidence Appendix**

There is no evidence submitted pursuant to 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal.

J. **37 CFR 41.37 (c)(1)(x) Related Proceedings Appendix**

An appendix containing a copy of the decision on appeal for Application 09/567,274 mailed August 18, 2004 is attached as Appendix II. An appendix containing a copy of the decision on appeal for application 09/401,939 mailed November 22, 2004 is attached as

Appendix III. An appendix containing a copy of the decision on appeal for application 09/401,198 mailed November 30, 2004 is attached as Appendix IV.

IV.   **37 CFR 47.37 (c)(2)**

This brief does not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.

V.   **37 CFR 41.37 (d)**

This brief is in compliance with the requirements of paragraph (c) of this section. Accordingly, this section is inapplicable.
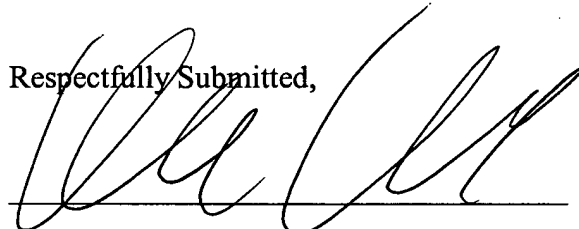

VI.   **37 CFR 41.37 (e)**

This appeal brief is filed timely. Accordingly, no extensions of time are necessary.

Respectfully Submitted,

1/28/05

Date

Richard A. Neifeld, Ph.D.

Registration No. 35,299

Attorney of Record

BTM
Printed: January 27, 2005 (6:02pm)
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Appendix I

32.   A system for delivering incentives over the Internet comprising:

a Web site for providing purchasing incentives from multiple sources;

a consumer purchase history database based on consumer online shopping activity;

a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering purchasing incentives to consumers by e-mail.

33.   The system of claim 32 wherein said means for delivering purchase incentives delivers purchasing incentives based on consumer profile.

34.   The system of claim 32 wherein the consumer purchase history database and said consumer database are integrated.

35.   The system of claim 32 wherein said Web site is an independently administered Web site.

36.   The system of claim 32 wherein said Web site is a cooperative site.

37.   The system of claim 32 wherein said consumer purchase history database includes data based on past purchasing activity.

38.   A system for delivering incentives over the Internet comprising:

a Web site for providing purchasing incentives from multiple sources;

a consumer purchase history database based on consumer online shopping activity;

a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

a means for delivering by e-mail notices which remind consumers to visit said Web site.

39.   The system of claim 38 wherein said means for delivering e-mail notices delivers notices based on consumer profile.

40.   The system of claim 38 wherein the consumer purchase history database and said consumer database are integrated.

41.   The system of claim 38 wherein said Web site is an independently administered Web site.

42.   The system of claim 38 wherein said Web site is a cooperative Web site.

43.   The system of claim 38 wherein said consumer purchase history includes data based on past purchasing activity.

44.   A system for delivering incentives over the Internet comprising:

a Web site for providing purchasing incentives from multiple sources;

a consumer purchase history database based on consumer online shopping activity;

a consumer database which can identify consumers by their e-mail addresses, wherein said consumer database is connected to said Web site so as to receive consumer data from said Web site; and

means for delivering by e-mail notices to purchase a specific manufacturer's product.

45.   The system of claim 44 wherein said means for delivering e-mail notices delivers notices based on consumer profile.

46.   The system of claim 44 wherein the consumer purchase history database and the consumer database are integrated.

47.   The system of claim 44 wherein said Web site is and independently administered Web site.

48.   The system of claim 44 wherein said Web site is a cooperative Web site.

49.   The system of claim 44 wherein said consumer purchase history database includes data based on past purchasing activity.

50.   A method for delivering purchasing incentives over the Internet comprising the steps of:

providing a Web site which offers shopping incentives from multiple sources;

maintaining a consumer purchase history database based on consumer online shopping activity;

receiving a consumer's e-mail address from a consumer's computer;

maintaining a consumer email database which can identify consumers by their e-mail address; and

transmitting purchase incentives via an e-mail post office.

51.   The method of claim 50 wherein the step of transmitting purchase incentives to the consumer by electronic mail includes transmitting purchase incentives based on a consumer

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profile.

52.   The method of claim 50 wherein the step of providing a Web site is performed by an independent Web site administrator.

53.   The method of claim 50 wherein the step of providing a Web site is achieved cooperatively.

54.   A method for delivering incentives over the Internet comprising the steps of:

providing a Web site which offers purchasing incentives from multiple sources;

maintaining a consumer purchase history database based on consumer online shopping activity;

receiving a consumer's e-mail address from a consumer's computer;

maintaining a consumer database which can identify consumers by their e-mail address; and

transmitting to consumers a notice to visit the Web site via the consumer's e-mail post office.

55.   The method of claim 54 wherein the step of providing a Web site is performed by an independent Web site administrator.

56.   The method of claim 54 wherein the step of providing a Web site is achieved cooperatively.

59.   The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises shopping list selections data.

60.   The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises rebate offers data.

61.   The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises notices detailing specific offers data.

62.   The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises focused incentives based on a consumer's prior shopping activity data.

63.   The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises purchasing incentives for data defining coupons

for subsequent printing by a consumer.

64. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises links to at least one of manufacturer and retailer web sites.

65. The system of claim 32 wherein said online shopping activity stored in said consumer purchase history database comprises data enabling a consumer to request at least one of information regarding a product and a sample of said product.

66. The system of claim 32 wherein said consumer purchase history database stores data from any online shopping activity.

67. The system of claim 32 wherein said consumer purchase history database stores an administrator of said system's web site data.

68. The system of claim 32 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands data.

69. The system of claim 32 wherein said consumer purchase history database stores data including at least three of said customer identification number, name, residential address, zip code, and email address.

70. The system of claim 32 wherein said consumer purchase history database stores selected consumer demographic information data, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

71. The system of claim 32 further comprising code for generating targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

72. The system of claim 32 further comprising code for generating untargeted incentives offered by manufacturers or retailers.

73. The system of claim 32 wherein said purchase incentives contain data enabling coupons to be printed by said consumer.

74. The system of claim 32 wherein said purchase incentives contain data enabling purchase incentives to be printed at point of sale.

75. The system of claim 32 further comprising means to encode in a consumer's identification card, tokens representing said purchase incentives.

76. The method of claim 50 wherein said online shopping activity data stored in said

consumer purchase history database comprises shopping list selections associated with a particular consumer.

77. The method of claim 50 wherein said online shopping activity data stored in said consumer purchase history database comprises rebate offers data associated with a particular consumer.

78. The method of claim 50 wherein said online shopping activity stored in said consumer purchase history database in association with an identification for a particular consumer comprises data detailing notice of specific offers provided to said particular consumer.

79. The method of claim 50 further comprising generating focused incentives for a consumer based on said consumer's prior shopping activity.

80. The method of claim 50 further comprising generating purchasing incentives data in a form suitable for printing of a coupon by a consumer.

81. The method of claim 50 further comprising generating links to at least one of manufacturer and retailer web sites and associating said links with a particular consumer.

82. The method of claim 50 further comprising enabling a consumer to request at least one of information regarding a product and a sample of a product.

83. The method of claim 50 wherein said consumer purchase history database stores data from an administrator of said system's web site.

84. The method of claim 50 wherein said consumer purchase history database stores retail store purchase data, including a consumer's favorite brands.

85. The method of claim 50 wherein said consumer purchase history database stores at least three of said customer identification number, name, residential address, zip code, and email address.

86. The method of claim 50 wherein said consumer purchase history database stores selected consumer demographic information, including at least two of number of persons in a household, age categories of persons in said household, and number of pets in said household.

87. The method of claim 50 wherein said purchase incentives include targeted, time phased incentives based on a consumer's actual buying patterns and preferences.

88. The method of claim 50 wherein said purchase incentives include untargeted incentives from at least one of manufacturers and retailers.

89.   The method of claim 50 further comprising printing said purchase incentives on a printer connected to and controlled by a consumer's computer.

90.   The method of claim 50 further comprising printing purchase incentives at point of sale.

91.   The method of claim 50 further comprising encoding in a consumer's identification card tokens representing said purchase incentives.

The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.
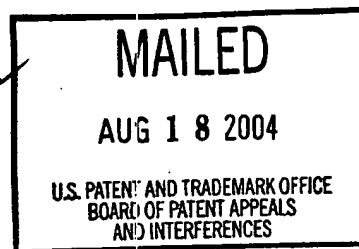
Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

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Review by Attorney: 8-26-04
Reminder- Req for Reconsideration:
9-18-04
File Req for Reconsideration:
10-18-04

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

<u>Ex parte</u> MICHAEL C. SCROGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND

_____

Appeal No. 2004-1420
Application No. 09/567,274

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ON BRIEF

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MAILED

AUG 1 8 2004

**U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before KRASS, JERRY SMITH and FLEMING, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal from the twice-rejected claims 28-43.[1]

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[1]The statement of the 35 U.S.C. § 103 rejection in both the answer and in Paper No. 19 indicates that the claims subject to this rejection are claims "34-43" with no indication that claims 28-33 have been rejected on this ground. However, since the body of the rejection in both the answer and in Paper No. 19 then goes on to indicate why claims 28-33 are rejected under 35 U.S.C. § 103, and appellants, by their arguments, clearly understand all

-1-

The invention relates to providing shopping incentives to customers through a computer network.

Representative of the sixteen independent claims is claim 28, reproduced as follows:

28. A method for distributing purchasing incentives to retail consumers over a computer network, said method comprising the steps of:

storing product purchase data pertaining to products purchased in association with an identification in a consumer purcahse history database;

storing an electronic mail address in association with said identification in a consumer electronic address database;

generating a purchase incentive in response to said identification being provided over said computer network, based on said product purchase data and depending upon frequency of prior use of purchase incentives generated for said identification; and

transmitting said purchase incentive to said electronic mail address.

The examiner relies on the following reference:

Barnett et al. (Barnett)   6,336,099   Jan. 1, 2002
                             (eff. filing date of Apr. 13, 1995)

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of claims 28-43 to stand rejected under 35 U.S.C. § 103, we will treat claims 28-43 as standing twice rejected under 35 U.S.C. § 103 and on appeal herein.

Claims 28-43 stand rejected under 35 U.S.C. § 103 as unpatentable over Barnett.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teachings, suggestions or implications in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).
These showings by the examiner are an essential part of complying
with the burden of presenting a prima facie case of obviousness.
Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444
(Fed. Cir. 1992). If that burden is met, the burden then shifts
to the applicant to overcome the prima facie case with argument
and/or evidence. Obviousness is then determined on the basis of
the evidence as a whole and the relative persuasiveness of the
arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ
685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472,
223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d
1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments
actually made by appellant have been considered in this decision.
Arguments which appellant could have made but chose not to make
in the brief have not been considered and are deemed to be waived
[see 37 CFR 1.192 (a)].

It is the examiner's position, with regard to instant claims
34, 35, 38 and 39, that Figure 1 of Barnett is indicative of a
system for distributing purchasing incentives to retail customers
over a computer network wherein a database is configured to store
product purchase data pertaining to products purchased in
association with an identification in a consumer purchase history

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database; and that Figure 9 and column 9, lines 59-67, teach a generation of an incentive based upon whether a signal containing the identification was reeived in a seleted prior time period.

The examiner also indicates that Barnett teaches the storing of an electronic mail address in association with said identification in a consumer electronic database at column 13, lines 58-67. However, the examiner indicates that Barnett does not specifically teach transmitting the incentives to the electronic mail address. But, since "the e-mail address for the user is stored...it would have been obvious...to have included transmitting incentives to the user's electronic e-mail address because such a modification would allow for distributing incentives that are transparent to the user (col. 4, lines 25-29)" (answer-page 3).

Specifically, with regard to claims 28, 29, 32, 33, 40 and 41, the examiner finds that purchase incentives generated based upon frequency of redemption of online purchase incentives generated for said identification (see page 4 of the answer) would have been obvious in view of Barnett's disclosure at (Figures 1-9 and column 7, lines 35-55).

The examiner cites Figure 9 of Barnett as evidence of the obviousness of the limitations of claims 30 and 31 and the

examiner cites Figures 1 and 9 of Barnett as evidence of the obviousness of the limitations of claims 36, 37, 42 and 43.

Appellants' position, with regard to claims 28, 29, 32 and 33 is that Figures 1-9 and column 7, lines 35-55 of Barnett do not disclose the claimed "generating said purchase incentive...based upon frequency of prior use of purchase incentives generated for said identification."

With regard to claims 30 and 31, appellants argue that Figure 9 of Barnett does not disclose the claimed "generating said purchase incentive for said identification based upon a frequency of prior use of an online system with said identification."

With regard to claims 34 and 35, appellants argue that Figure 9 of Barnett, column 6, lines 62-66, which describes this figure, and column 9, lines 59-67, do not disclose "generating an incentive based upon whether a signal containing said identification was received in a selected prior time period..."

With regard to claims 36 and 37, appellants argue that Figures 1 and 9 of Barnett do not disclose "generating a purchase incentive based on said product purchase data including whether said identification is associated with redemption of an online purchase incentive during a selected prior time period..."

With regard to claims 38 and 39, appellants argue that Figure 9 and column 9, lines 59-67, of Barnett do not disclose "generating a purchase incentive in response to said identification being provided over said computer network, based at least in part upon frequency of selection of purchase incentives generated for said identification."

With regard to claims 40 and 41, appellants argue that Barnett does not disclose the concept of generating a purchase incentive at least in part on frequency of redemptions of online purchases generated for an identification.

With regard to claims 42 and 43, appellants argue that Figures 1 and 9 of Barnett do not disclose "generating a purchase incentive in response to said identification being provided over said computer network and based at least in part upon whether said identification is associated with selection of an online purchase incentive during a selected prior time period..."

With regard to all of the claims, 28-43, appellants argue that column 13, lines 58-67, of Barnett, does not disclose "storing an electronic mail address in association with said identification in a consumer electronic database." It is appellants' view that it would not have been obvious to store an electronic mail address in association with said identification

in said consumer electronic address database "because the

automatic deletion of expired coupons in the user's computer

database taught by Barnett and the modification of redemption

amounts of coupons in the user's database taught by Barnett do

not suggest storing the user's email address as a transmission

address" (principal brief-page 10).

We AFFIRM.

It appears to us that the examiner has set forth a

reasonable case, identifying claim limitations and pointing out

where, in the reference, such limitations can be found or why the

claimed subject matter would have been obvious in view of

specific teachings of Barnett. Thus, we find that the examiner

has established a prima facie cae of obviousness.

Yet, appellants' main response is that Barnett "does not

disclose" some limitation quoted from the claims. However,

appellants do not explain why they take these positions in view

of the examiner's rationale. It is not enough for appellants to

merely state that the reference does not disclose something when

the examiner has pointed out where and how the reference is

considered to have disclosed something or to have made that

something obvious. 37 CFR 1.192(c)(8)(iv) requires appellants'

arguments to "specify the errors in the rejection and, if

appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art" (emphasis added).

Appellants get somewhat specific with regard to the storing of an electronic mail address in association with said identification in a consumer electronic database by arguing that it would not have been obvious to store an electronic mail address in association with said identification in said consumer electronic address database "because the automatic deletion of expired coupons in the user's computer database taught by Barnett and the modification of redemption amounts of coupons in the user's database taught by Barnett do not suggest storing the user's email address as a transmission address" (principal brief-page 10).

However, we agree with the examiner that while Barnett may not specifically teach the claimed storing of an electronic mail address in association with said identification in a consumer electronic database, it would have been obvious to do so. This is so because Barnett clearly teaches storing a user's e-mail Internet address (column 13, lines 62-65) and since the online

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system maintains the user's e-mail Internet address, it would have been clearly obvious to associate a particular user with his/her particular e-mail address and to use such address for any desired transmission to a user.

We note that appellants do not address the obviousness of providing for the claimed storing of an electronic mail address in association with said identification in a consumer electronic database. They merely argue that the reference does not disclose this. It should be noted that this is not an anticipation rejection based on 35 U.S.C. 102, but rather an obviousness rejection based on 35 U.S.C. § 103. Accordingly, the mere allegation by appellants that the applied reference does not disclose a particular claim limitation is not dispositive of the issue of obviousness. Appellants must explain, in view of the examiner's reasonable rationale, why the claimed subject matter would not have been obvious, i.e., appellants must point out the alleged errors in the rejection. This, appellants have not done.

In the reply brief, appellants get more specific regarding the argument that the reference does not disclose the "frequency" limitation. That is, in reviewing column 7, lines 35-55, of Barnett, appellants argue that while the coupon distribution center 16 utilizes the user-specific redemption data, along with

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user-specific demographic data supplied by the online service

provider 2, this passage does not disclose generating a purchase

incentive based at least in part upon <u>frequency</u> of use or

redemption of incentives.

We agree with appellants that Barnett does not specifically

disclose generating the incentive based at least in part upon

<u>frequency</u> of use or redemption. But, again, the rejection is

based on obviousness under 35 U.S.C. § 103, rather than

anticipation. The reference does not need to specifically

disclose the generation of incentives based at least in part upon

<u>frequency</u> of use or redemption, as long as there is some

suggestion to do so or something that would have led the artisan

to base the incentive generation at least in part upon <u>frequency</u>

of use or redemption.

The cited portion of column 7 of Barnett makes it clear that

distribution of user-specific data to the coupon distribution

center is of value and that such data is used for marketing

analysis so that subsequent coupon packages may be targeted

specifically at certain users. The reference also makes it clear

thereat that the coupon distribution center utilizes the user-

specific redemption data along with the user-specific demographic

data supplied by an online service provider in order to compile
subsequent coupon data.

It appears to us that the artisan would have recognized that
frequency of use or redemption is part of the user-specific data
and/or user-specific redemption data taught by Barnett. Users
who employ coupons more frequently are more likely to be targets
to whom coupons will be offered and the coupon issuer would be
very interested in this statistic in determining whom to target.
Therefore, the artisan would have found it obvious, in view of
Barnett's disclosure, to base the generation of incentives _at
least in part_, upon _frequency_ of use or redemption of such
incentives.

Appellants have offered nothing to show error in such
rationale because appellants do not attack the obviousness of
generating incentives based at least in part upon frequency of
use or redemption; they merely state that Barnett does not
disclose this.

Accordingly, appellants' arguments are not persuasive of
unobviousness and fail to overcome the _prima facie_ case of
obviousness established by the examiner.

The examiner's decision rejecting claims 28-43 under
35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

ERROL A. KRASS)
Administrative Patent Judge)
)
)
)
JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
)
MICHAEL R. FLEMING)
Administrative Patent Judge)

EK/RWK

NEIFELD IP LAW, PC
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ARLINGTON, VA 22202

Appendix III

The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

Paper No. 29
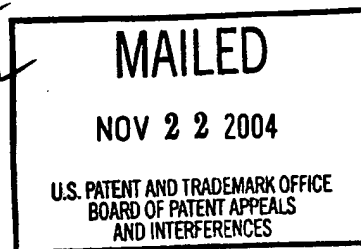
UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Atty Review: 12-9-04

_____

<u>Ex parte</u> MICHAEL C. SCOGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND

_____

Appeal No. 2004-0989
Application No. 09/401,939

_____

ON BRIEF

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MAILED
NOV 2 2 2004
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
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Before KRASS, JERRY SMITH and FLEMING, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 32-70.

The invention is directed to providing shopping aids and incentives to customers through a computer network. In particular, purchasing incentives are distributed to a consumer by transmitting promotion data identifying a plurality of product

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discounts from a main computer to the consumer's computer and

displaying the plurality of product discounts at the consumer's

computer based on the promotion data. Selection data designating

at least one product discount selected from the plurality of

product discounts is then transmitted from the consumer's

computer to the main computer.

Representative independent claim 32 is reproduced as

follows:

32. A computer implemented method for distributing
purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of
product discounts from a main computer to a personal computer
over a computer network;

displaying said plurality of product discounts at said
personal computer based on said promotion data;

transmitting selection data designating at least one product
discount selected from said plurality of product discounts from
said personal computer to said main computer over said computer
network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said
personal computer over said computer network;

identifying said token data in a retail store in association
with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

The examiner relies on the following references:

Day et al. (Day)   5,857,175   Jan. 5, 1999

Scroggie et al. (Scroggie)   5,970,469   Oct. 19, 1999
                                                              (filed Mar. 26, 1996)

Claims 32-70 stand rejected under 35 U.S.C. § 112, first and second paragraphs, as relying on a disclosure lacking enablement and a written description, and as being vague and indefinite.

Claims 32-70 stand further rejected under 35 U.S.C. § 102(b) as anticipated by Day.

Claims 32-70 stand further rejected under 35 U.S.C. § 103 as "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike" (answer-page 5).

Claims 32-70 stand still further rejected under obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469 to Scroggie.

Claims 32-70 stand even still further rejected under

35 U.S.C. § 103 "over copending US Patent Application 09/567,274"

(answer-page 8).[1]

Reference is made to the briefs and answer for the

respective positions of appellants and the examiner.

OPINION

We turn, first, to the rejection of claims 32-70 under

35 U.S.C. § 112, first paragraph.

The examiner contends that the claimed steps of transmitting

selection data designating at least one product discount selected

from a plurality of product discounts from a personal computer to

a main computer over a computer network and generating token data

depending on selection data are "not enabled by the

specification." The examiner also contends that the inventors

did not have possession of the claimed invention at the time of

filing because the specification does not discuss transmitting

selection data designating at least one product discount selected

from a plurality of product discounts from a personal computer to

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[1] While the examiner indicates the rejection is based on
"prior art" in stating that the rejection is under "35 U.S.C.
§ 103, it is clear from the examiner's explanation, especially,
at the bottom of page 15 in the answer, that the rejection is
really a provisional rejection based on obviousness-type double
patenting.

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a main computer over a computer network and generating token data depending on selection data.

It is the examiner's position that these claimed features are not enabled by the instant specification since the "examiner considers them to be concepts that cannot be practically applied to any embodiment of the invention" such that skilled artisans could make and use the invention.

The examiner's position regarding the rejection of the claims under 35 U.S.C. § 112, first paragraph, is unreasonable and we will not sustain these rejections.

As a matter of Patent and Trademark Office practice, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of 35 U.S.C. 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt does exist, a rejection for failure to teach how to make and/or use will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the teaching

contained in the specification is truly enabling, <u>In re</u>

<u>Marzucchi</u>, 439 F.2d 220, 169 USPQ 367 (CCPA 1971); <u>In re Sichert</u>,

566 F.2d 1154, 196 USPQ 209 (CCPA 1977).

When a rejection is made on the basis that the disclosure

lacks enablement, it is incumbent upon the examiner to explain

why he doubts the truth or accuracy of any statement in a

supporting disclosure and to back up assertions with acceptable

evidence or reasoning which is inconsistent with the contested

statement. The examiner has not advanced any such evidence or an

acceptable line of reasoning inconsistent with enablement and,

therefore, has not sustained his burden.

Not only has the examiner not set forth any reasonable basis

for challenging the sufficiency of disclosure, asserting, without

explanation, that he deems the claimed features to be merely

"concepts that cannot be practically applied" (answer-page 4),

but it appears to us that the claimed features of "transmitting

selection data designating at least one product discount selected

from a plurality of product discounts from a personal computer to

a main computer over said computer network" and "generating token

data depending on said selection data" merely entail programming

web sites to provide the functionality claimed. This

functionality of transmitting data selected from a plurality of

choices and generating other data in dependence on the selection

data does not appear to us to be anything out of the ordinary for

the skilled web programmer and would not entail any undue

experimentation on his/her part.

Accordingly, we will not sustain the rejection of claims 32-

70 under 35 U.S.C. § 112, first paragraph, based on non-

enablement.

With regard to written description, we also will not sustain

the rejection of claims 32-70 on this ground.

The examiner again points to the claim language,

"transmitting selection data designating at least one product

discount selected from a plurality of product discounts from a

personal computer to a main computer over said computer network"

and "generating token data depending on said selection data" and,

now, alleges that since the specification does not discuss these

claimed features, it is not considered that the applicants had

possession of what they now claim as their invention at the time

of filing the instant application.

Appellants point to page 9, lines 4-5, of the instant

specification for a disclosure of a customer selecting a coupon

offer from a plurality of offers after log-in and switching to an

offer browser.

With regard to "generating token data...," appellants point

to page 24, lines 2-6, of the specification. Since this portion

of the specification states that

> Generating a "token" instead of coupon, as described
> above with reference to FIG. 13, also reduces the risk
> of fraud. Another technique similar to this is
> depicted in FIG. 18. A token 316 is generated by the
> user's computer 302 after interaction with the
> distribution sever 300. The user chooses from
> incentive offers as described above, but instead
> of a coupon the computer 302 generates the token 316,

it is clear to us that applicants did, indeed, have possession of

the invention which they now claim.

Thus, we will not sustain the rejection of claims 32-70

under the written description clause of 35 U.S.C. § 112, first

paragraph.

Turning to the rejection of the claims under 35 U.S.C.

§ 112, second paragraph, the examiner alleges that the claims are

indefinite because there is no antecedent basis for "transmitting

selected data" or "generating token data" in the claimed steps of

transmitting selection data designating at least one product

discount selected from a plurality of product discounts from a

personal computer to a main computer over said computer network

and generating token data depending on said selection data. The

examiner also alleges that the instant specification also does

not provide an antecedent basis for these claim limitations.

First, we point out that the second paragraph of 35 U.S.C. § 112 is directed to the claims, not the specification. We may look to the specification to give meaning to an otherwise misunderstood claim limitation but the claims themselves must provide the antecedent basis for the specific claimed steps/elements.

Moreover, the inquiry under 35 U.S.C. 112, second paragraph, is whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed-not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary skill in the pertinent art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

In the instant case, taking claim 32 as exemplary, the steps of "transmitting selection data..." and "generating a token data..." are first time recitations within the claim and the recited steps themselves provide the antecedent basis for the steps. Thus, the examiner's concern for "antecedent basis" is not understood. It is not as if the claims recited "said step of

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transmitting selection data..." and never previously recited such data.

Accordingly, we find that the examiner's rejection under 35 U.S.C. § 112, second paragraph, has no basis, in fact. The claims do set out and circumscribe a particular area with a reasonable degree of precision and particularity and, as such, are in accordance with 35 U.S.C. § 112, second paragraph. The examiner has failed to reasonably show any indefiniteness within the claims.

Thus, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 112, second paragraph.

The examiner's next rejection deals with anticipation of the claims under 35 U.S.C. § 102(b) over Day.

A claim is anticipated only when a single prior art reference expressly or inherently discloses each and every element or step thereof. Constant v. Advanced Micro-Devices Inc., 848 F.2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988); RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). If the examiner presents a reasonable basis for alleging inherency, the burden shifts to appellant to come forward, if they can, with evidence to the contrary. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); In re Ludtke, 441

F.2d 660, 169 USPQ 563 (CCPA 1971); In re Swinehart, 439 F.2d
210, 169 USPQ 226 (CCPA 1971).

It is the examiner's position that claims 32-70 are "clearly
anticipated" by Day, without any explanation in the statement of
the rejection at page 5 of the answer.

In response to appellants' arguments, the examiner explains
his position, at pages 11-14 of the answer. That position is
that column 1, line 64 through column 2, line 5, and column 3,
line 20, anticipates all of the claimed subject matter with
regard to the independent claims.

The examiner basically relies on the background section of
Day, wherein is described an in-store terminal which a consumer
may access. A list of coupons is presented to the consumer, and
a link between the terminal and check-out stations in the store
permits discounts selected by the consumer to be subtracted from
the total bill on check-out.

We would agree that, given the broadest, reasonable
interpretation of "personal computer," "computer network" and
"main computer," one might consider the in-store terminal
described in Day as a "personal computer" since it is used by the
consumer. One may even consider the link between the terminal
and the check-out stations to be part of a "computer network."

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Possibly, the main check-out stations might constitute the claimed "main computer."

However, it is not clear from the description in Day, or from the examiner's explanation, that the main computers (i.e., the main check-out stations) are actually transferring the promotion data to the personal computer (i.e., the consumer terminals). The instant claims require the main computer to transfer promotion data identifying a plurality of product discounts to a personal computer over a computer network.

But, even if we assume that the check-out stations described in the cited portions of Day do, in fact, transmit the promotion data to the customer terminal and even if we assume, then, that Day would teach the claimed steps of "transmitting promotion data...," "displaying said plurality of product discounts..." and "transmitting selection data...," the examiner's case would still fail because the instant claims all require an element/step of "generating token data depending on said selection data."

The examiner's rationale is that this generation of token data is "considered an implicit patentable equivalent to the disclosed discounts subtracted from a consumer's total bill wherein the claimed token data functionality is met by the

-12-

disclosed discount subtraction" (answer-page 12), referring to lines 3-4 of column 2 in Day.

The cited portion of Day refers to "discounts selected by the consumer." This may be equivalent to the claimed "...at least one product discount selected..." in the "transmitting selection data..." paragraph of claim 32, for example. But, this cited portion of Day cannot then also serve as disclosing the next claimed step of "generating token data depending on said selection data" because it is only after the selection is made that a token, depending on said selection data, can be generated.

Moreover, we do not see how the generation of such token data can be "implicit" as urged by the examiner.

The examiner has pointed to nothing in the Day disclosure which even suggests the claimed generation of "token data." Without a teaching of this token data, Day cannot identify any such token data or determine discount items being purchased from undisclosed token data.

Accordingly, since the examiner's rationale fails to convincingly point, in the applied reference, to the claimed "token data," the examiner has failed to establish a prima facie case of anticipation and we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 102(b).

We do point out, in passing, however, that should the examiner have convinced us of a teaching of such "token data" in Day, appellants' arguments would have been insufficient to overcome such a <u>prima facie</u> case since appellants merely argue that Day does not disclose what is recited in the claims, without specifically pointing out any perceived errors in the examiner's position, and without specifically identifying particular claimed features which are considered to distinguish over Day.

Nevertheless, since the burden to establish a <u>prima facie</u> case of anticipation rests initially on the examiner, and, in our view, the examiner clearly failed to meet that burden in this case, we do not reach appellants' arguments.

The examiner's next rejection, under 35 U.S.C. § 103, is based on "an obvious variation of examiner's personal knowledge of consumer purchasing incentive distribution provided by PerformanceBike."

The examiner contends that since "at least 1994, PerformanceBike has performed the claimed method, system and program..." The examiner states that he

> has personal knowledge of instant or subsequent redeemable vouchers, separate shopping lists based on selected product discounts, main to personal computer shopping list transmission, specific manufacturer or specific retailer discounts, demographic data or token

use or product use frequency basis, and
internet/intranet token scanning identification. The
claimed promotion data transmission and product
discount display occur when the examiner went into a
PerformanceBike retail outlet store and viewed
discounted products from a sales catalog. The
selection data transmission occurs when the examiner
uses the red courtesy phone (functionally equivalent to
a claimed personal computer) and calls the retail
outlet distribution center (functionally equivalent to
the claimed main computer). The generating,
transmitting, and identifying token data occurs when
examiner's frequent buyer card bar code number is
processed for the product selection data made from the
red courtesy phone (examiner's frequent buyer card bar
code number is the same as the claimed token data).
The step of determining discount items being purchased
occurs when the retail outlet distribution center
verifies the final purchase order of the examiner.
Generating purchase incentive based on discount items
occurs when the examiner is credited with frequent
buyer points rewarded for discount item purchased...
The claimed invention...has been provided by
PerformanceBike long before the filing of applicants'
invention. Examiner takes Official notice that it is
old and well known...to claim the invention as recited
by the applicant by substituting terms with patentably
equivalent claim language, in order to overcome the
explicit teachings of the examiner's experienced prior
art. Furthermore examiner experience teaches the
claimed invention except for the personal computer
display. It would have been obvious...to provide a
personal computer display since the computer display is
merely an automated feature of a concept that is old
and well known... It is considered that the claim
recitations using ʻcomputer" are an attempt to automate
an old and well known process provided by
PerformanceBike... (answer-pages 6-7).

Appellants argue, at pages 15-20 of the principal brief,

that the PerformanceBike website has not been established as

prior art and the examiner has offered no physical evidence to support the examiner's assertions.

We have considered the examiner's assertions and appellants' arguments thereagainst and we conclude that the examiner has simply not established that his experience with PerformanceBike would constitute a prima facie case of obviousness against the instant claimed subject matter. Without physical evidence and/or a more detailed written description as to how the PerformanceBike retail system works, we are not persuaded by the examiner's declaration of experience that the frequent buyer card bar code number would read on the generating, transmitting and identifying steps in paragraphs 5-7, for example, of claim 32, or that a red courtesy phone may be considered the claimed "personal computer." We are also not convinced that the claimed transmitting promotion data would be met by merely walking into a PerformanceBike retail store so that the information is "transmitted" to the consumer.

Since the examiner's experience is not convincing as to obviousness of the instant claimed subject matter, we will not sustain the rejection of claims 32-70 under 35 U.S.C. § 103 based on the examiner's experience with PerformanceBike.

The examiner also rejected claims 32-70 under obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469.

As the examiner explained, at page 8 of the answer, while the claims are not identical, they are not patentably distinct from each other because "the patented feature of encoded data is an obvious variation of the application claimed token and because both perform the same function in the same manner with the same result."

It is our view that the examiner makes at least a reasonable case since the "token" of the instant claims does appear to be similar to the patented "purchasing incentive containing in encoded form the identity of the retailer designated by the customer..." In the face of this rather reasonable finding of obvious-type double patenting, appellants' sole argument is that the patented claims

> define transmitting purchase incentives associated with recipes, whereas the present claims define identifying token data in a retail store for generating purchase incentives. One would not have been obvious in view of the other (principal brief-page 22).

Thus, appellants merely assert that the instant claims would not have been obvious over the patented claims but do not point to any error in the examiner's reasoning. It is not enough to

argue that the instant claims define identifying token data in a

retail store when the patented claims are also clearly directed

to generating purchase incentives for a retail store. Appellants

have offered nothing to show any non-obviousness difference

between the claimed "token" and the encoded purchasing incentive,

while the examiner has made out a reasonable case that one would

have been obvious over the other.

Accordingly, we will sustain the rejection of claims 32-70

over obviousness-type double patenting over claims 1-3 of U.S.

Patent No. 5,970,469.

Finally, we turn to the examiner's rejection of the claims

"under 35 U.S.C. § 103(a) as being obvious over copending US

Patent Application 09/567,274," which, as explained supra, is

really a provisional rejection based on obviousness-type double

patenting.

It appears to be the examiner's position that the difference

between the instant claims and the claims in the copending

application is in the recitation, by the latter, of the

generation of redeemable vouchers, separate shopping list

transmission, etc. and that the instant claims would have been

obvious thereover, especially since the instant claims appear to

be broader in scope.

The examiner's position does not appear to be unreasonable. Yet, appellants do not dispute the merits of the rejection. Instead, they argue only that the copending application is not prior art because it "appears from the PTO website to be unpublished" (principal brief-page 24). Appellants appear to be responding to a rejection thought to be under 35 U.S.C. § 103. However, the examiner made it clear, in the response section of the answer, that this rejection was really a provisional obviousness-type double patenting rejection. In filing a reply brief, appellants had an opportunity to respond to this rejection but, for whatever reason, chose not to do so. Thus, in effect, we have no response from appellants with regard to the rejection.

If the copending application has been, or will be, abandoned, then this rejection becomes moot. However, if the copending application remains pending with the claim language identified by the examiner, then this "provisional" rejection appears to us to be proper.

Accordingly, we will sustain this provisional rejection of claims 32-70 over copending application Serial No. 09/567,274, based on obviousness-type double patenting, as appellants have convinced us of no error in the examiner's position.

Rejections which were previously made by the examiner but not repeated in the answer are not before us. Accordingly, contrary to appellants' request, we will not treat such rejections.

CONCLUSION

We have not sustained the rejection of claims 32-70 under 35 U.S.C. § 112, first and second paragraphs. We also have not sustained the rejection of claims 32-70 under 35 U.S.C. § 102(b) or under 35 U.S.C. § 103 based on an obvious variation of the examiner's personal knowledge of incentives by PerformanceBike.

We have, however, sustained the rejection of claims 32-70 based on obviousness-type double patenting over claims 1-3 of U.S. Patent No. 5,970,469, and over claims of copending application Serial No. 09/567,274.

Therefore, the examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

ERROL A. KRASS   )
Administrative Patent Judge   )
)
)
)
JERRY SMITH   )
Administrative Patent Judge   ) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)
)
MICHAEL R. FLEMING   )
Administrative Patent Judge   )

EK/RWK

Appeal No. 2004-0989
Application No. 09/401,939

NEIFELD IP LAW, PC
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

The opinion in support of the decision being entered today was <u>not</u> written for publication and is <u>not</u> binding precedent of the Board.

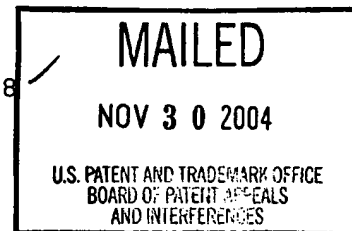Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

Atty Review : 12-7-04

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

<u>Ex parte</u> MICHAEL C. SCROGGIE, MICHAEL E. KACABA,
DAVID A. ROCHON and DAVID M. DIAMOND

Appeal No. 2004-0738
Application No. 09/401,198

ON BRIEF

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MAILED
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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
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Before KRASS, JERRY SMITH and FLEMING, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

<u>DECISION ON APPEAL</u>

This is a decision on appeal from the final rejection of claims 32-67.

The invention is directed to providing shopping aids to customers through a computer network. In particular, a prompt for personal information from a main computer to a personal computer is transmitted over a network; personal information data

-1-

is transmitted over the network from the personal computer to the

main computer responsive to the prompt; page data defining a web

page based on the personal information is generated; and a web

page address to that web page is assigned.

Representative independent claim 32 is reproduced as

follows:

32. A computer implemented method for generating a web page,
said method comprising the steps of:

transmitting a prompt for personal information from a main
computer to a personal computer over a computer network;

transmitting personal information data from said personal
computer to said main computer over said computer network in
response to said prompt;

generating page data defining a web page based upon said
personal information; and assigning a web page address to said
web page based upon said personal information.

The examiner relies on the following reference:

Angles et al. (Angles)   5,933,811   Aug. 3, 1999
                                               (filed Aug. 20, 1996)

Claims 32-67 stand rejected under 35 U.S.C. § 103 as

unpatentable over Angles.

Reference is made to the briefs and answer for the

respective positions of appellants and the examiner.

<u>OPINION</u>

The examiner points to Figures 1-3, 7, and 9-11, and column 5, lines 62-67, column 6, lines 4-14, column 7, lines 19-42 and column 8, lines 10-19 and 33-67, of Angles and alleges that while these cited portions of the reference lack "explicit" recitation of all of the elements of the claim, e.g., independent claim 32, it would have been obvious to arrive at the instant claimed subject matter

> because such a method supports customization "which can contain hyper-links to other information. The hyper-links typically direct the user's Internet browser to access different websites on the Internet...In addition, to executing the content provider script, the advertisement provider also obtains the consumer's member code from the consumer computer. The advertisement provider uses the consumer's member code to identify the consumer's demographic profile and preferences..." (See Angles (col. 4, ll. 6-14; and col. 3, ll. 53-65)). (Answer-pages 6-7).

We will sustain the rejection of claims 41-67 under 35 U.S.C. § 103 because the examiner has established a <u>prima facie</u> case of obviousness. We will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103 because, in our view, the examiner has not established such a case with regard to the subject matter of these claims.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a <u>prima facie</u> case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d

1955, 1956 (Fed. Cir. 1993). To reach a conclusion of

obviousness under § 103, the examiner must produce a factual

basis supported by a teaching in a prior art reference or shown

to be common knowledge of unquestionable demonstration. Our

reviewing court requires this evidence in order to establish a

prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223

USPQ 785, 787-88 (Fed. Cir. 1984). The examiner must not only

identify the elements in the prior art or that knowledge

generally available to one of ordinary skill in the art would

lead the individual to combine the relevant teachings of the

references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598

(Fed. Cir. 1988).

In the instant case, the examiner merely alleges that each

and every claim limitation is either taught or suggested by

Angles or that the claimed subject matter would have been obvious

even though the examiner points to not one of the claimed

elements/steps having a corresponding teaching in the applied

reference. It is unclear from the examiner's explanation,

exactly what elements/steps of Angles are considered to

correspond to the claimed elements/steps.

It is clear to us that Angles teaches a method of delivering advertisements to a consumer's computer and, in doing so, there is a transmission of a prompt for personal information from a main computer to a personal computer and also a transmission of personal information from the personal computer to the main computer in response to the prompt. It is clear from column 3, lines 18-28, of Angles, that the reference suggests the claimed transmission of a prompt for, and transmission of, personal information data from/to a main computer and a personal computer.

However, the examiner has never explained where, in Angles, is to be found the claimed "generating page data defining a web page based upon said personal information; and assigning a web page address to said web page based upon said personal information."

We note that column 4, lines 7-9, of Angles discloses that advertisements sent to a consumer's computer may contain hyper-links to other information and that the "hyper-links typically direct the user's Internet browser to access different websites on the Internet." In our view, one may fairly interpret this disclosure as a teaching of "generating page data defining a web page based upon said personal information" since the advertisements sent to a consumer in Angles are based on personal

information of the consumer and the hyper-links in the advertisement lead to a web page which is generated from some page data. But, even if we accept such an interpretation, and we do, this still does not reveal where the claimed limitation of "assigning a web page address to said web page based upon said personal information" is to be found, or suggested, in Angles.

In responding to appellants' arguments, the examiner merely replies with general platitudes regarding the law on obviousness as well as "cogent reasons to modify the teachings of <u>Angles,</u>" (answer-page 59). The examiner cites various cases, and various portions of Angles, at pages 58-69 of the answer, but the examiner never offers any specifics as to just how, exactly, specific teachings of Angles are considered to disclose or suggest the specific claim limitations, especially the limitation anent "assigning a web page address..."

Generalities are not sufficient to establish obviousness under 35 U.S.C. § 103. The examiner must give specifics as to how the prior art is applied against the claimed subject matter. "[T]he Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." <u>In re Lee</u>, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

Similarly, the examiner must also make findings based on material facts documented on the record. Yet, the examiner, in this case, has not shown how, in accordance with the record of this case, Angles suggests "assigning a web page address to said web page based upon said personal information." The examiner may not merely allege obviousness, without finding a single claimed element/step in the reference, by stating that the disclosure of Angles "supports customization..."

At page 68 of the answer, the examiner asserts that teachings in an unapplied reference to Legarde anent associating URLs and hyper-links with assigning a web page address to a web page based on personal information, would have been "inherently disclosed in Angles in view of Legarde."

Not only is it not understood how the assigning of a web page address to a web page based on personal information can be "inherent," but the examiner appears to be basing this "inherency," indeed, basing the entire rejection, on a reference which is not even part of the statement of rejection. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the

rejection. <u>In re Hoch</u>, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

While there may possibly be some convincing reason why the disclosure in Angles might be considered to obviate the instant claimed subject matter, within the meaning of 35 U.S.C. § 103, by somehow suggesting the claimed "assigning a web page address to said web page based upon said personal information," the examiner clearly has not provided it.

Accordingly, we will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103 as set forth by the examiner.

With regard to claims 41-67, we will sustain the rejection of these claims under 35 U.S.C. § 103 because these claims do not include the limitation of "assigning a web page address to said web page based upon said personal information." Rather, these claims merely recite the generation of page data defining a web page based on the personal information and the transmission of the page data. As explained, <u>supra</u>, we consider the disclosure of Angles, at column 4, lines 7-9, to suggest such a generation and transmission of page data.

Even where some of the claims, e.g., claim 50, recite a "personalized web page," this is considered suggested by the hyper-links in Angles because these hyper-links lead to a web

page as a result of the personal information. Accordingly, the web pages displayed as a result may be considered "personalized web pages."

In claim 42, there is a step of "communicating a web page address for said web page" recited. However, this is different from the recitation, in claim 32, for example, of "assigning a web page address to said web page" because there is no assignation. Rather, claim 42 merely requires a communication of a web page address for a web page, which may be the web page to which the hyper-link takes the user in Angels. It does not require assigning a web page address to the web page, that was defined by the generation of page data, based upon the personal information.

Accordingly, we will sustain the rejection of claims 41-67 under 35 U.S.C. § 103, but we will not sustain the rejection of claims 32-40 under 35 U.S.C. § 103.

The examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

ERROL A. KRASS)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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MICHAEL R. FLEMING)
Administrative Patent Judge)

EK/RWK

-10-

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Attachment 1

internet address   [Search]

⦿ Dictionary   ◯ Thesaurus   ◯ Web

Home

Dictionary - Thesaurus - Web

Get the Most Popular Sites for "internet address"

3 entries found for *internet address.*

internet address

<networking> (IP address, TCP/IP address) The 32-bit host
address defined by the Internet Protocol in STD 5, RFC
791. It is usually represented in dotted decimal notation.

A hosts's Internet address is sometimes related to its
Ethernet address. The Internet address is usually expressed
in dot notation, e.g. 128.121.4.5. The address can be split
into a network number (or network address) and a host
number unique to each host on the network and sometimes
also
a subnet address. The way the address is split depends on
its "class", A, B or C as determined by the high address bits:

Class A - high bit 0, 7-bit network number, 24-bit host
number. n1.a.a.a 0 <= n1 <= 127

Class B - high 2 bits 10, 14-bit network number, 16-bit host
number. n1.n2.a.a 128 <= n1 <= 191

Class C - high 3 bits 110, 21-bit network number, 8-bit host
number. n1.n2.n3.a 192 <= n1 <= 223

The Internet address must be translated into an Ethernet
address by either ARP or constant mapping.

The term is sometimes used incorrectly to refer to a host's

ADVERTISEMENT

fully qualified domain name.

[Jargon File]

(1994-12-06)

Source: *The Free On-line Dictionary of Computing,* © *1993-2004 Denis Howe*

internet address

<networking> (Note lower case "i"). An IP address that uniquely identifies a node on an internet.

[Jargon File]

(1995-04-12)

Source: *The Free On-line Dictionary of Computing,* © *1993-2004 Denis Howe*

internet address

n. 1. [techspeak] An absolute network address of the form foo@bar.baz, where foo is a user name, bar is a
sitename, and baz is a `domain' name, possibly including periods
itself. Contrast with bang path; see also the network and
network address. All Internet machines and most UUCP sites can
now resolve these addresses, thanks to a large amount of
behind-the-scenes magic and PD software written since 1980 or so.
See also bang path, domainist. 2. More loosely, any network address reachable through Internet; this includes bang path addresses and some internal corporate and government networks.

Reading Internet addresses is something of an art. Here are the
four most important top-level functional Internet domains followed
by a selection of geographical domains:

com
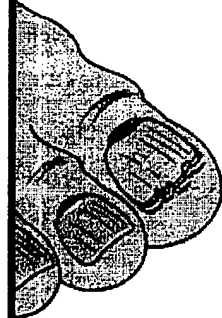
commercial organizations

edu
educational institutions

gov
U.S. government civilian sites

mil
U.S. military sites

Note that most of the sites in the com and edu domains are in
the
U.S. or Canada.

us
sites in the U.S. outside the functional domains

su
sites in the ex-Soviet Union (see kremvax).

uk
sites in the United Kingdom

Within the us domain, there are subdomains for the fifty
states,
each generally with a name identical to the state's postal
abbreviation. Within the uk domain, there is an ac subdomain
for
academic sites and a co domain for commercial ones. Other
top-level
domains may be divided up in similar ways.

Source: *Jargon File 4.2.0*

Perform a new search, or try your search for
"internet address" at:

- Amazon.com - Shop for books, music and more
- Reference.com - Search the Web
- eLibrary - Search thousands of newspapers and
  magazines
- Google - Search the Web for relevant results
- Google Groups - Search Usenet messages back to
  1981
- Merriam-Webster - Search for definitions

- <u>Roget's Thesaurus</u> - Search for synonyms and antonyms

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